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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91185325
Party	Defendant Olympic Mountain and Marine Products, Inc.
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

<hr/>	:	
LA SENZA CORP.,	:	
Opposer,	:	Opposition No. 91185325
v.	:	APPLICANT'S MOTION FOR LEAVE TO AMEND AND FOR SUMMARY JUDGMENT
OLYMPIC MOUNTAIN AND MARINE PRODUCTS, INC.,	:	
Applicant.	:	
<hr/>		

Pursuant to Rule 2.107(a) of the Trademark Rules of Practice and Fed.R.Civ.P. 15(a)(2), Applicant Olympic Mountain and Marine Products, Inc. hereby moves for leave to amend its Answer in the above-referenced proceeding to assert a counterclaim for fraud and cancellation of Registration No. 1,800,379, followed by dismissal of the instant opposition or, in the alternative, to assert the affirmative defense of unclean hands, followed by dismissal of the instant opposition. Pursuant to Rule 2.127 of the Trademark Rules of Practice and Fed.R.Civ.P. 56, Applicant further moves for summary judgment dismissing the instant opposition. A memorandum in support of this motion setting forth the grounds for relief is attached hereto.

Olympic Mountain and Marine Products, Inc.

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Dated: October 1, 2009

CERTIFICATE OF SERVICE

I hereby certify that on this 1st day of October, 2009, a true copy of the foregoing Applicant's Motion for Leave to Amend and for Summary Judgment, together with the attached Memorandum of Law in Support of Motion, was served by first-class mail, postage prepaid, upon counsel for Opposer:

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Rena Millet

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
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LA SENZA CORP.,	:	
Opposer,	:	
v.	:	Opposition No. 91185325
OLYMPIC MOUNTAIN AND MARINE PRODUCTS, INC.,	:	
Applicant.	:	

**APPLICANT'S MEMORANDUM IN
SUPPORT OF MOTION FOR LEAVE TO
AMEND AND FOR SUMMARY JUDGMENT**

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Introduction and Background

Applicant Olympic Mountain and Marine Products, Inc. ("Olympic") is a manufacturer and wholesaler of scented candles, diffusers, soaps and bath salts based in Kent, Washington. Supp. Interrog. Answer No. 2 (Exhibit A).¹ ESSENZA was first used in interstate commerce as a mark for scented candles. The first use was by Olympic's predecessor-in-interest, Aroma Therapy of Rome, a Texas corporation, on March 1, 1997. Interrog. Answer No. 1 (Exhibit B). The mark has been used continuously since that time for scented candles,² and since February 6, 2007 for scent diffusers. Supp. Interrog. Answer No. 2 (Exhibit A).

This opposition proceeding concerns Olympic's application Serial No. 77/071,961, ESSENZA for "scented oils used to produce aromas when heated, essential oils for household use" in Class 003; and "scent diffusers comprised of a container and wood rods used to diffuse oil scent poured in the container" in Class 021. This application was filed by Olympic on December 27, 2006 under Lanham Act Section 1(b) but, as noted above, Olympic began making extensive use of the ESSENZA

¹ "Interrog. Answer" refers to Applicant's Response to Opposer's First Set of Interrogatories, dated June 16, 2009; "Supp. Interrog. Answer" refers to Applicant's Supplemental Response to Opposer's First Set of Interrogatories, dated September 30, 2009.

² Registration No. 2,184,021, ESSENZA for candles in Class 004, was cancelled on May 16, 2009, due to the inadvertent failure of former counsel to file a Section 8 declaration. Declaration of Philip A. Kantor, Esq., dated September 29, 2009 ("Kantor Dec.") ¶ 2 and Ex. 1. A replacement application was filed by Olympic on June 17, 2009 seeking registration of ESSENZA for candles in Class 004 under Lanham Act Section 1(a) based on a date of first use in interstate commerce of March 1, 1997. Kantor Dec. ¶ 3 and Ex. 2.

mark for the sale of scent diffusers in interstate commerce starting on February 6, 2007.³ Since first introducing its line of ESSENZA scent diffuser products, Olympic has sold \$[redacted] worth of them to the public (Supp. Interrog. Answer No. 2 (Exhibit A)) through large retailers such as Costco Warehouse Clubs (Interrog. Answer No. 6 (Exhibit D)).

According to the Notice of Opposition, dated July 21, 2008 (the “Opposition Complaint” or “Opp. Complaint”), ¶ 2, opposer La Senza Corporation (“La Senza”) is a retailer of “ladies wearing apparel, lingerie, loungewear, skin care products, and related goods and accessories, including, but not limited to, body oils, bath oils and massage oils” based in Mississauga, Ontario. A copy of La Senza’s U.S. home page as it appeared on the World Wide Web on September 27, 2009 is annexed as Ex. 3 to the Kantor Declaration. Kantor Dec. ¶ 4. For purposes of this opposition, La Senza relies on its Registration No. 1,800,379 (the “379 Registration”). Opp. Complaint, ¶ 3. According to the copy of the ‘379 Registration annexed as Exhibit 1 to the Opposition Complaint, as well as the allegations of paragraph 3 of the Opposition Complaint, the registration covers LA SENZA for “conditioners and skin moisturizing creams; toilet soaps; body, hand and face lotions [in Class 003], as well as make-up bags sold empty [in Class 018].”

Olympic’s Answer to the Notice of Opposition was filed by former counsel on August 28, 2008, denying the salient allegations of the complaint, but asserting no affirmative defenses or counterclaims. The parties waived initial disclosures, and neither

³ In case the Board is unfamiliar with scent diffusers, a picture of samples of Olympic’s scent diffuser products is annexed in Exhibit C (taken from Applicant’s Response to Opposer’s First Request for Production of Documents, Bates No. A352). The product consists of a bottle of scented oil into which the user places wood rods (packaged with the product). The rods wick up the scented oil and diffuse it into the surrounding air.

side served expert disclosures. The discovery period ended without Olympic's former counsel seeking any discovery on behalf of Olympic. On the last day of the discovery period, La Senza served extensive discovery requests, including requests for documents, interrogatories and requests to admit. Olympic responded to La Senza's discovery requests through current counsel. La Senza's trial period has not yet commenced.

With discovery now complete, and the trial period not yet begun, Olympic submits that the case is ripe for summary adjudication.

Summary of Argument

Olympic's grounds for dismissal of the opposition are twofold. First, Olympic contends that La Senza committed fraud, and approaches the Board with unclean hands. According to paragraph 3 of the Opposition Complaint, the '379 Registration is "valid and subsisting, and constitutes evidence of Opposer's ownership of Opposer's LA SENZA mark, and exclusive right to use same in commerce in connection with the goods set forth in said registration, namely, conditioners and skin moisturizing creams; toilet soaps; body, hand and face lotions, as well as make-up bags sold empty."

However, Olympic has discovered that this representation to Olympic and to the Board is false and fraudulent because, as a matter of record, La Senza long ago abandoned all goods under the cited registration save for body lotions. The identification of goods in the registration is clearly material to the issue of likelihood of confusion presented in this proceeding. As explained below, there is a significant body of precedent by this tribunal and its reviewing court, the Court of Appeals for the Federal Circuit, holding that the misrepresentation of a goods and services identification is grounds for

cancellation of the misrepresenting party's registration. Accordingly, Olympic seeks leave to amend its Answer to assert a counterclaim for cancellation of the '379 Registration or, in the alternative, for leave to amend its Answer to assert the affirmative defense of unclean hands, resulting in the dismissal of the opposition.

Second, Olympic submits that the two marks at issue in this proceeding, namely, ESSENZA for "scented oils used to produce aromas when heated, essential oils for household use, and scent diffusers comprised of a container and wood rods used to diffuse oil scent poured in the container," and LA SENZA for "body lotions," are so dissimilar as to negate likelihood of confusion as a matter of law.⁴

Summary Judgment Standard

Rule 56 of the Federal Rules of Civil Procedure provides for the entry of summary judgment where there "is no genuine issue as to any material fact," and where the moving party is entitled to judgment as a matter of law. Fed.R.Civ.P. 56(c); *Conroy v. Reebok Int'l. Ltd.*, 14 F.3d 1570, 29 U.S.P.Q.2d 1373 (Fed. Cir. 1994); *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 248 (1986) (material facts are those "that might affect the outcome of the suit under governing law").

There are two issues raised in this summary judgment motion: (1) that La Senza committed fraud warranting cancellation of the '379 Registration and/or dismissal

⁴ Paragraph 9 of the Opposition Complaint asserts that "[o]n information and belief, the registration of the ESSENZA mark as set forth in the opposed application, *may be likely to cause confusion* ... vis-à-vis Opposer's LA SENZA mark ..." (emphasis supplied). Though "may be likely to cause confusion" is not the relevant standard under Lanham Act § 2(d) — the relevant standard is "as to be likely to cause confusion" — La Senza's hesitation is certainly apt.

of the opposition, and (2) that there is no likelihood of confusion as a matter of law. Both of these issues are issues that have been addressed and disposed of by the Trademark Trial & Appeal Board on summary judgment motions. Applicable authority establishing this, as well as the facts that are not genuinely disputed, will be shown below in connection with the detailed discussion of the issues.

Leave to Amend

On October 20, 1999, La Senza's Chairman, Irving Teitelbaum, signed a declaration under Section 8 of the Lanham Act, stating that the LA SENZA mark was being used in interstate commerce for conditioners and skin moisturizing creams, toilet soaps, body, hand and face lotions as well as make-up bags sold empty. Kantor Dec. ¶ 6 and Ex. 5. On October 16, 2003, La Senza's president, Laurence Lewin, signed a combined Declaration of Use in Commerce/Application for Renewal under Sections 8 and 15 of the Lanham Act, stating that the LA SENZA mark was being used in interstate commerce for body lotions. Kantor Dec. ¶ 7 and Ex. 6. Despite the omission of all other goods from the combined declaration, the Trademark Office issued a Notice of Acceptance and Notice of Renewal stating that "the registration will remain in force for classes 003 and 018."⁵ Kantor Dec. ¶ 8 and Ex. 7. Olympic submits that these three facts are matters of record, and cannot be genuinely disputed.

⁵ This error was fostered, if not caused by La Senza's failure to comply with Trademark Rule § 2.161(e)(2), which provides that "[i]f the affidavit or declaration covers less than all the goods or services, or less than all the classes in the registration, specify the goods or services being deleted from the registration ..." (see, also, § 2.161(f)(2), requiring the registrant to state when use of the mark stopped). Had La Senza complied with this provision, it would have been apparent that goods and classes were being dropped from the registration, resulting in proper Notices of Acceptance and Renewal.

Trademark Office records are now wrong. They show the '379 Registration as covering goods beyond just body lotions (though Class 018 goods are now shown as cancelled), despite the fact that body lotions are the only goods the registration now covers.⁶ Kantor Dec. ¶ 9 and Ex. 8. Olympic submits that these facts are matters of record, and cannot be genuinely disputed.

Against this background, La Senza has commenced an opposition proceeding affirmatively claiming likelihood of confusion based on the '379 Registration. In support of the claim, La Senza affirmatively states that the '379 Registration is "valid and subsisting, and constitutes evidence of Opposer's ownership of Opposer's LA SENZA mark, and exclusive right to use same in commerce in connection with the goods set forth in said registration, namely, conditioners and skin moisturizing creams; toilet soaps; body, hand and face lotions, as well as make-up bags sold empty." However, given that the '379 Registration, based on the declaration of La Senza's president, now covers only body lotions, support for the likelihood of confusion claim is false and fraudulent, and calculated to have a material effect on the outcome of this proceeding.

Misrepresentations made in a goods and services identification constitute grounds for a finding of fraud. *Sinclair Oil Corporation v. Sumatra Kendrick*, 85 U.S.P.Q.2d 1032, 1035 (TTAB 2007). Such fraud warrants cancellation of a registration. *Hachette Filipacchi Presse v. Elle Belle LLC*, 85 U.S.P.Q.2d 1090, 1093 (TTAB 2007). Typically, fraud occurs where an applicant misrepresents the goods or services he is using in connection with registering a trademark or filing a Section 8 declaration. *See*, for

⁶ The Combined Declaration Under Sections 8 and 15 can no longer be changed. Trademark Rule § 2.164(b).

example, *Sinclair Oil*, *supra* at 1035-6; *Hachette Fillipacchi Presse*, *supra* at 1093-4; *Kipling Apparel Corp. v. Rich*, Opp. No. 91/170,389, TTAB 2007, Dkt. #16 dated April 16, 2007 at p. 2; *Hurley International LLC v. Volta*, 82 U.S.P.Q.2d 1339, 1341-2 (TTAB 2007); *Herbaceuticals, Inc. v. Xel Herbaceuticals, Inc.*, 86 U.S.P.Q.2d 1572, 1574 (TTAB 2008); *Grand Canyon West Ranch LLC v. Hualapai Tribe*, 88 U.S.P.Q.2d 1501, 1507 (TTAB 2008) (“The clear message of the cases involving false claims of use of the mark on goods or services, *wherever they may appear*, is that these statements are essential to the integrity of the application and registration process. ... In an application or registration, the identification of goods or services defines the scope of the rights claimed” (emphasis supplied) at p. 1509.). Typically, also, the Board makes its fraud finding on a motion for summary judgment. *Sinclair Oil*, *supra* at 1037; *Hachette Fillipacchi Presse*, *supra* at 1095; *Kipling Apparel*, *supra* at p. 7; *Hurley International*, *supra* at 1346; *Herbaceuticals*, *supra* at 1578.

This may be a case of first impression. Olympic does not allege that La Senza misrepresented its use of the LA SENZA mark to the Trademark Office (though by not fully complying with Trademark Rule § 2.161, La Senza set the Trademark Office on the path of inaccuracy). However, La Senza affirmatively made a false and fraudulent representation regarding the coverage of its LA SENZA mark in the instant proceeding, and the misrepresentation is material to the proceeding. The question — not directly answered by the cited precedent — is whether the misrepresentation may serve as grounds for cancellation of the ‘379 Registration (as would normally be true in a case of fraud), or merely as unclean hands, properly leading to dismissal of the instant opposition?

Given the lack of precedent directly answering this question, Olympic seeks guidance from the Board in the form of alternative requests for relief. Should the Board agree that the fraud present here warrants cancellation of the '379 Registration, then Olympic seeks this relief in the form of leave to amend its Answer to assert a counterclaim for fraud and cancellation, followed by dismissal of the opposition. Should the Board find that the fraud present here is more relevant to this proceeding than it is to the '379 Registration generally, then Olympic alternatively seeks relief in the form of leave to amend its Answer to assert the affirmative defense of unclean hands and dismissal of the opposition.

Leave to amend should be freely given when justice so requires. Trademark Rule § 2.107(a) and Fed.R.Civ.P. 15(a)(2). For all of the foregoing reasons, Olympic's motion for leave to amend should be granted, along with the additional relief requested.

Likelihood of Confusion

The Board analyzes likelihood of confusion cases using the factors set forth in *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 U.S.P.Q. 563, 567 (CCPA 1973). However, it is entirely proper for a case to turn on just one or two factors, where they clearly establish similarity or dissimilarity. *Ava Enterprises Inc. v. P.A.C. Trading Group, Inc.*, 86 U.S.P.Q.2d 1659, 1660 (TTAB 2008); *Champagne Louis Roederer, S.A. v. Delicato Vineyards*, 148 F.3d 1373, 1375, 47 U.S.P.Q.2d 1459, 1461 (Fed. Cir. 1998); *Kellogg Company v. Pack'em Enterprises, Inc.*, 951 F.2d 330, 333, 21 U.S.P.Q.2d 1142, 1144 (Fed. Cir. 1991); *In re the Hearst Corporation*, 982 F.2d 493, 494, 25 U.S.P.Q.2d 1238, 1239 (Fed. Cir. 1992). It is also entirely proper for such cases to be decided on motions for summary judgment, especially where the decisive *du Pont*

factor is dissimilarity of the marks. *Kellogg Company, supra*; *Ava Enterprises, supra* (motion for judgment on the pleadings).

a. Dissimilarity of the Marks in Appearance, Sound and Connotation

ESSENZA and LA SENZA are no more similar than TALK to STALK, or ABLE to TABLE. Any visual or phonetic similarity is simply outweighed by the overall differences in the marks.

The “La” portion of the LA SENZA mark forms a separate word, and is clearly perceived — both in spoken and written form — as the article “the” in the Italian language of the mark.⁷ (Notably, La Senza itself recognized this, providing the translation for the ‘379 Registration in two parts: “The word “LA” translates from Italian to the English word “the.” The word “SENZA” translates from Italian to the English word “without.”) To the extent consumers are unfamiliar with even rudimentary Italian, they would have the same perception based on the same meaning in all of the romance languages, including Spanish, French and Portuguese, as well in American usage, such as la Niña (a climatic phenomenon routinely discussed in American news and weather reports), la dolce vita (a common expression used in America), La Quinta (the trademark of a well-known American motel chain), La Jolla (an American place name), etc. In short, the significance of “La” in this context is widely known to express the article “the” modifying a separate word. Thus, even hearing the LA SENZA mark spoken, consumers would note that it is a two-word mark, negating confusion with Olympic’s one-word mark.

⁷ As a matter of record (and undisputed fact), LA SENZA means “the without.” See, Opp. Complaint Exhibit 1.

By contrast, the “Es” of ESSENZA creates an entirely different word meaning “essence.” Kantor Dec. ¶ 10 and Ex. 9. Olympic submits that this is a matter of record and undisputed fact. Again, consumers unfamiliar with foreign languages would nevertheless perceive and understand this meaning, based upon the similarity of the mark ESSENZA to the word “essence” in English, as well as recognition familiarity (at all educational levels) with the way in which many words in Romance languages vary from their English equivalents (*e.g.*, ranch/rancho, palace/palazzo, grand/grande). Because the meaning of Olympic’s ESSENZA mark is so apparent, even consumers unable to appreciate the meaning of LA SENZA as “the without,” but mistakenly translating the mark as “the sense” would make no association between a mark understood to mean “the sense” with a mark understood to mean “essence,” as these two meanings are very different.⁸

This analysis leads to a key point of differentiation between the marks: connotation. The connotation of Olympic’s mark is the essential oil used to make Olympic’s scented products. Interrog. Answer No. 8 (Exhibit E). Olympic submits that it chose this mark because the connotation of essential oil is entirely apparent to consumers of scented products, suggesting high quality.

Just as the “essential oil” connotation of Olympic’s ESSENZA mark has been made of record, and cannot be genuinely disputed based on common sense and reasoning, so the connotation of the LA SENZA mark can be readily discerned from common sense and reasoning. To start, La Senza’s website leaves no doubt about the company’s

⁸ Regarding the validity of this type of analysis, see the Board’s opinion in *Champagne Louis Roederer* quoted at length below.

emphasis on apparel. The home page (Kantor Dec. Ex. 3) displays apparel products exclusively. The “About La Senza” page, in its entirety, states as follows:

Our mission is to provide an outstanding lingerie presentation in a world class environment. La Senza provides customers with outstanding personal service, while combining quality, fit and value. The merchandise continues to satisfy two areas of customer needs: firstly, La Senza strives to become the destination specialty lingerie store for all consumers and secondly, to provide a constant range of merchandise relevant to the gift purchaser.

Since the first store opening in 1990, La Senza has maintained a focused vision of excellence. The La Senza brand name has become synonymous with high quality, affordability and elegance, and La Senza takes pride in dedicating itself to its customers and merchandise.

As Canada’s premier lingerie retailer, La Senza owns and operates over 300 stores throughout Canada, and a further 300 stores in 30 more countries around the world.

La Senza offers women a unique shopping experience with outstanding lingerie presentation in a beautiful and intimate environment, featuring everything from bras & panties, to sleepwear, loungewear, bodycare, and accessories.

Please [click here](#) to read our Social Responsibility statement.

Kantor Dec. ¶ 5 and Ex. 4.

The purpose of citing the foregoing references from La Senza’s website is not to contrast the goods of the respective parties (this contrast is the subject of a separate showing made below). Rather, these references are cited for what they teach about the *connotations* of the parties’ marks. LA SENZA, “the without,” connotes the sexy, risqué quality of La Senza’s apparel products. This is apparent from the overwhelming dominance of apparel to La Senza’s product lines and stores, and to the obvious meaning

the mark has in relation to apparel. This conclusion does not exist in a vacuum.

According to the *International Directory of Company Histories*, the LA SENZA brand name was coined for the creation of a chain of lingerie boutique stores in Canada equating to the (then) successful, sexually provocative VICTORIA'S SECRET chain in the U.S. Kantor Dec. ¶ 11 and Ex. 10, p.2.

Olympic submits that this connotation cannot be genuinely disputed. It is thus plain that LA SENZA, connoting sexy, risqué apparel, has nothing in common with ESSENZA, connoting "essential oil."

Connotation can of course be key in a likelihood of confusion case. In *Champagne Louis Roederer, supra*, the Court of Appeals affirmed the Board's holding that the marks CRISTAL for champagne and CRYSTAL CREEK for wine were not confusingly similar. After brushing aside each of the applicant's defenses (mere descriptiveness of the CRISTAL mark, label differences, differences in pronunciation, absence of actual confusion), the Board nevertheless held for the applicant, writing as follows:

Notwithstanding all of the foregoing, we find that there is no likelihood of confusion in this case because of the differences in the marks CRISTAL and CRISTAL CHAMPAGNE, on the one hand, and CRYSTAL CREEK, on the other. Comparing applicant's mark CRYSTAL CREEK, considered in its entirety, to opposer's mark CRISTAL (the mark of opposer which is most similar to applicant's mark), it is clear that the two marks differ substantially in significance. We note, in this regard, that the noun "crystal" is defined in Webster's New World College Dictionary, *supra*, as, inter alia, "a clear, transparent quartz"; "a very clear, brilliant glass"; "articles made of this glass, such as goblets, bowls, or other ware"; and "anything clear and transparent like crystal", while the adjective form of the word is defined as, inter alia, "of or

composed of crystal” and “like crystal; clear and transparent.” Opposer’s mark CRISTAL is likely to be recognized by purchasers as the French language equivalent of the English word “crystal” or, to those unfamiliar with the French language, as a phonetic misspelling of the word “crystal.” In either case, CRISTAL would likely signify to purchasers (in addition to its acquired significance as a trademark for opposer’s champagne) the clear or transparent nature of opposer’s champagne and/or the crystal bottles in which the product was originally sold. Applicant’s mark CRYSTAL CREEK, in contrast, conjures up the image of a very clear (and hence probably remote from civilization) creek or stream. Moreover, there are differences between the marks in sound and appearance. Because of the differences in the marks in significance, sound, and appearance, they create distinctly different commercial impressions.

Champagne Louis Roederer, 1997 TTAB Lexis 61 at *13-15 (TTAB 1997); see Kantor Dec. ¶¶ 23-25 and Exs. 22-24.

Plainly, the instant proceeding presents an *a fortiori* case. The word “crystal/cristal” as used by both parties in *Champagne Louis Roederer* had the same basic meaning, namely, “clear.” For one party, the connotation was clarity of the product or the bottle for the product; for the other party, the connotation was the clarity of a stream, suggesting remoteness from civilization. Here, the marks do not even share the same meanings, “the without” versus “essence,” leading to entirely different connotations or commercial impressions: “having to do with risqué, sexy apparel” versus “essential oil.”

Dissimilar connotations can readily overcome phonetic similarity in a likelihood of confusion case. Thus, FROOTIE ICE was not held confusingly similar to FRUIT LOOPS (*Kellogg Company, supra*, 951 F.2d at 333, 21 U.S.P.Q.2d at 1145); CRYSTAL CREEK was not held confusingly similar to CRISTAL (*Champagne Louis Roederer, supra*); KASTLE SYSTEMS was not held confusingly similar to CASTLE

WATCHERS (*In re Kastle Systems, Inc.*, TTAB decision dated Nov. 30, 1984 at p. 8, Serial Nos. 332,494 and 332,495; Kantor Dec. ¶ 20 and Ex. 19); VARGAS was not held confusingly similar to VARGA GIRL (*In re the Hearst Corporation, supra*, 982 F.2d at 494, 25 U.S.P.Q.2d at 1239). Courts have reached the same result even where *virtually all* parts of the marks were phonetically identical. *See, Standard Brands, Inc. v. Eastern Shore Canning Co., Inc.*, 172 F.2d 144, 146, 80 U.S.P.Q. 318, 320-1 (4th Cir. 1949) (finding the marks VA for vegetables and tomato juice not confusingly similar to V8 for vegetable juice). Indeed, the Board has even so held where *all* parts of the marks were phonetically identical. *See, In re Software Design, Inc.*, 220 U.S.P.Q. 662 (TTAB 1983) (no likelihood of confusion found between DOX for computer programming services and DOC'S for the custom manufacture of computer systems, based on difference in connotation, namely, documents versus doctorates). Given that LA SENZA and ESSENZA are *not* phonetically identical, there should surely be no likelihood of confusion found here.⁹

⁹ Non-precedential cases by the Board provide excellent examples of the foregoing principles. *See, for example, In re Zolo Technologies, Inc.*, TTAB decision dated Aug. 13, 2002 at p. 9, Serial Nos. 76/035,119, 76/035,120 and 76/035,301 (*see* Kantor Dec. ¶ 21 and Ex. 20), holding no likelihood of confusion between ZOLO and SOLO. The Board contrasted the connotations of the two marks by observing that SOLO is a known term, whereas ZOLO is fanciful. Similarly, here, ESSENZA, meaning "essence," is a known term, whereas LA SENZA is essentially fanciful (though it has meaning). *See, also, In re Beauty FX, Inc.*, TTAB decision dated June 12, 2003 at p. 8, Serial No. 76/238,909 (*see* Kantor Dec. ¶ 22 and Ex. 21), no likelihood of confusion found between COLOR FX and COLOR EFFECTS — "When marks are only similar in sound, we proceed a little more cautiously before determining there is a likelihood of confusion." *See, also, Chatham International Incorporated v. Indomita Wine, S.A.*, Opp. No. 91/170,389, TTAB 2005, Dkt. #16 dated Aug. 24, 2005 at page 11, "[w]hen we consider all the evidence of record, we conclude that while there are some similarities between the marks QUANTUM and QUINTIS, we agree that the differences in pronunciation, appearance, meaning and commercial impression outweigh any similarities in the marks."

b. Dissimilarity of the Parties' Goods

All of the foregoing would properly negate a likelihood of confusion finding even if the parties' goods were similar. However, the parties' goods are not at all similar: "scented oils used to produce aromas when heated, essential oils for household use, and scent diffusers comprised of a container and wood rods used to diffuse oil scent poured in the container" versus "body lotions."

Olympic notes that La Senza sought to frame the issue differently by introducing itself as a company selling "ladies wearing apparel, lingerie, loungewear, skin care products, and related goods and accessories, including, but not limited to, *body oils, bath oils and massage oils* ..." (emphasis supplied). Opp. Complaint, ¶ 2. Plainly, La Senza drafted the complaint to make it appear that its goods overlap Olympic's goods.

However, the '379 Registration, which properly frames the issue (*In re Big Pig, Inc.*, 81 U.S.P.Q.2d 1436, 1439 (TTAB 2006); *Squirtco v. Tomy Corporation*, 697 F.2d 1038, 1042-3, 216 U.S.P.Q. 937, 940 (Fed. Cir. 1983)), nowhere lists oils of any kind in its identification of goods. Moreover, there is no other LA SENZA registration that fills the gap.

An intent-to-use application for LA SENZA LINGERIE and design filed by La Senza on November 28, 2000 (Serial No. 76/172,127) claimed "massage oil" in its goods and services ID, but the application was abandoned on August 26, 2003 without any allegation of use. Kantor Dec. ¶ 12 and Ex. 11. An intent-to-use application for LA SENZA AQUA filed by La Senza on November 30, 2000 (Serial No. 76/173,653) claimed "massage oil" and "body oil" in its goods and services ID, but the application

was abandoned on August 8, 2002 without any allegation of use. Kantor Dec. ¶ 13 and Ex. 12. An intent-to-use application for LA SENZA SPA filed by La Senza on September 2, 2003 (Serial No. 76/542,041) claimed “oils” in its goods and services ID, but the application was abandoned on September 19, 2005 without any allegation of use. Kantor Dec. ¶ 14 and Ex. 13. Finally, in a pending application for the mark LOVE LA SENZA filed on January 13, 2009 — bearing a priority date of July 17, 2008, which is long after Olympic’s filing and use — La Senza seeks to register LOVE LA SENZA for “a weekend kit containing warming massage oil” among other things. Kantor Dec. ¶ 15 and Ex. 14. In regard to this last reference, besides being junior to Olympic’s trademark filing and use, and beside the difference between “warming massage oil” and “scented oils used to produce aromas when heated,” the marks are different: LOVE LA SENZA versus ESSENZA. In sum, La Senza’s allusion to body oils, bath oils and massage oils in the Opposition Complaint should be given no weight.¹⁰ If anything, La Senza’s allusion to these oil products in the Opposition Complaint serves to underscore the difference between La Senza’s putative cosmetic products, and Olympic’s household products. Thus, for summary judgment purposes, as shown below, it makes no difference whether La Senza benefits from all inferences flowing from the Opposition Complaint, and the oil products alleged in the Opposition Complaint are assumed to be real.

With this background, the Board may conclude, as a matter of law, that the parties’ goods do not overlap such that the parties’ concurrent use of the marks LA SENZA and ESSENZA might cause consumers to make an association between the

¹⁰ As an additional matter, keyword searches on La Senza’s website for the keywords “massage oil,” “bath oil” and “body oil” yield zero direct hits, but rather turn up results featuring different types of LA SENZA products. Kantor Dec. ¶¶ 16-18 and Exs. 15-17.

parties. This is intuitively true based on the obvious difference between the cosmetic product, body lotions, set forth in the '379 Registration, and the household products set forth in Olympic's pending application. (Construing all inferences in favor of Opposer, and thus including body oils, bath oils and massage oils in the analysis changes nothing, as these are cosmetic, versus household products.) Turning again to *Squirtco*, *supra*, the Court of Appeals wrote at pp. 1042-3 of 697 F.2d, p. 940 of 216 U.S.P.Q. (emphasis supplied):

As the United States Court of Customs and Patent Appeals repeatedly stated, where the likelihood of confusion is asserted with a registered mark, the issue must be resolved on the basis of the goods named in the registration and, *in the absence of specific limitations in the registration*, on the basis of all normal and usual channels of trade and methods of distribution.

In this case, the parties have indeed taken care to specifically limit the range of their respective goods: “scented oils used to produce aromas when heated, essential oils for household use, scent diffusers comprised of a container and wood rods used to diffuse oil scent poured in the container,” versus “body lotions” (and, construing all inferences in favor of Opposer, “body oils, bath oils and massage oils”). What is the use of all of this specificity if not here in the context of an opposition proceeding? Manifestly, the pending application demarcates its separate domain, and should be allowed to proceed unhindered to registration.

Finally, there can be no genuine dispute that Olympic and its predecessors-in-interest have used the ESSENZA mark for years to sell over \$[redacted] worth of scented candles. Interrog. Answer No. 2 (Exhibit A). It can also not be genuinely disputed that La Senza has no presence in the scented candle business under the LA SENZA mark, or

certainly no presence even approximating Olympic's presence in this market. Olympic submits that consumers encountering the ESSENZA mark for its scented oil and diffuser products would be far more likely to associate them with the maker of ESSENZA scented candles than with the maker of LA SENZA body lotions, much less LA SENZA brassieres and lingerie. These two sets of goods, scented oils and diffusers on the one hand, and scented candles on the other, travel through similar trade channels to similar consumers at similar times of year for similar purposes. Weighed together with the similarity of brand name (ESSENZA scented oils and diffusers compared to ESSENZA scented candles versus ESSENZA scented oils and diffusers compared to LA SENZA body lotions), there can be no genuine dispute that consumers would associate ESSENZA scented oils and diffusers with the maker of ESSENZA scented candles, not with the maker of LA SENZA body lotions (or body, bath or massage oils).

* * *

Olympic submits that no other *du Pont* factors play a significant role in this proceeding. The factor which might have played a role, if it existed, is actual confusion in the marketplace, since the parties have used their marks concurrently since February 6, 2007, during which time Olympic sold \$[redacted] worth of scent diffuser products throughout the United States and Canada. However, there is no evidence of actual confusion. Consequently, this factor also weighs in favor of dismissal of the opposition.

Conclusion

For all of the foregoing reasons, Olympic respectfully prays that:

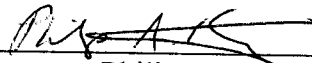
(i) it be granted leave to amend its Answer to assert a counterclaim for fraud and cancellation of the '379 Registration, followed by dismissal of the instant opposition or, in the alternative, to assert the affirmative defense of unclean hands, followed by dismissal of the instant opposition;

(ii) it be granted summary judgment dismissing the instant opposition;

(iii) its application, Serial No. 77/071,961, be allowed to proceed to registration on the Principal Register; and

(iv) for such other and further relief as may be proper.

Respectfully submitted,



Philip A. Kantor

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Attorneys for Applicant

Dated: September 30, 2009

EXHIBIT A

— REDACTED —

EXHIBIT B

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

LA SENZA CORP., :
Opposer, :
v. : Opposition No. 91185325
OLYMPIC MOUNTAIN AND
MARINE PRODUCTS, INC., :
Applicant. :

**APPLICANT'S RESPONSE TO OPPOSER'S
FIRST SET OF INTERROGATORIES**

1. State the earliest date on which Applicant will rely in this proceeding to establish any rights in Applicant's mark vis-à-vis Opposer, and state in detail the basis for Applicant's claim of rights in Applicant's mark as of that date, including:

Response: March 1, 1997. This is the date on which Applicant's predecessor in interest, Aromatherapy of Rome ("AOR"), a Texas corporation, first used the mark ESSENZA in interstate commerce for candles in Class 4. The candles sold by AOR in interstate commerce continuously from that time have always consisted predominantly of scented candles. Applicant considers candles, especially scented candles, as closely related to the goods covered in

the trademark application at issue in this proceeding, namely, Serial No. 77/071,961 (the "Application"), which are scented oils used to produce aromas when heated and essential oils for household use in Class 3, and scent diffusers comprised of a container and wood rods used to diffuse oil scent poured in the container in Class 21. The goods covered in the Application are well within the zone of natural expansion of the ESSENZA mark for candles.

On September 9, 1998, AOR merged with Washington Aromatherapy of Rome, Inc., with the surviving company being the latter. On July 6, 1999, Washington Aroma Therapy of Rome, Inc. assigned a security interest in the trademark ESSENZA to Business Factors, Inc. On December 3, 1999, Washington Aromatherapy of Rome, Inc. changed its name to Big Wick Candle Company, Inc. and maintained the security interest to Business Factors, Inc. On November 20, 2000, Business Factors, Inc. foreclosed its security interest in the ESSENZA mark and assigned it to Aroma Candle and Scent Company. On December 30, 2005, Applicant acquired the ESSENZA mark from Aroma Candle & Scent Company. The documents showing each of these assignments and successions are submitted with these interrogatory responses.

AOR applied for trademark registration on the Principal Register of the ESSENZA word mark (in typed drawing form) for candles on July 31, 1997. The mark was duly registered on August 25, 1998, and has been continuously maintained by the various successor companies set forth above to the present day. As shown by the specimens filed in support of AOR's trademark application for ESSENZA under Lanham Act Section 1A, the mark has been used on candles in the same typeface and with the same graphical logo as Applicant uses the same mark on candles today, as well as on the goods covered in the Application.

(a) a description of the manner of use of Applicant's mark as of that date (i.e., store signage, imprinted on the goods, on labels or tags for the goods, on packaging for the goods, in store displays, etc.);

Response: Mark has been continuously used on candles by Applicant and its predecessors on labels affixed to the goods and on packaging for the goods.

(b) the identity of each person involved in any way in such use, including, but not limited to the identity of each witness who can testify on personal knowledge as to such use;

Response: Jeff Stice - CEO, Olympic Mountain Products, Inc., 8655 S. 208th Street, Kent, WA 98031; Laurie Severe - Accounting, 32454 46th Place, South Auburn, WA 98001; Spencer Krenke, c/o True Labs, Seattle, WA; Robert Schwai, c/o True Labs, Seattle, WA.

(c) the identification of each product and/or service in connection with which the mark was used on that date; and

Response: Applicant does not have a list of each product and/or service sold under the ESSENZA mark on March 1, 1997. However, the specimens filed by AOR in support of the registration of the ESSENZA mark for candles under Lanham Act Sec. 1A on July 31, 1997 are submitted with these interrogatory responses, identifying three products sold by AOR in interstate commerce under the ESSENZA mark as of that date, namely, an ESSENZA unscented white candle, an ESSENZA "for fragrance" honeydew candle, and an ESSENZA "aromatherapy" "calm" lavender & vanilla scent candle.

Also submitted with these interrogatory responses and identifying ESSENZA products sold by AOR (and successors) through the time the ESSENZA mark and registration were acquired by Applicant are the following:

(i) Email from Laurie Severe to Jeff Stice dated July 12, 2006 enclosing a 2002 Aroma Candle and Scent Company price list for ESSENZA candles;

(ii) A March 14, 2006 candle inventory by Applicant of ESSENZA candles from Aroma Candle and Scent Company;

(iii) March 14 and 16, 2006 emails from Laurie Severe to Jeff Stice discussing the foregoing inventory as labeled for Aroma Candle and Scent Company customer, Fred Meyer;

(iv) A close-out offer from Applicant to Ross Stores dated September 8, 2006 for inventory from Aroma Candle and Scent Company;

(v) Email string between Laurie Severe and Jeff Stice of February 7 and 10, 2006 regarding the ESSENZA artwork transition from Aroma Candle and Scent to Applicant;

(vi) Aroma Candle and Scent Company Inventory Valuation Report - Finished Goods created on December 28, 2005;

(vii) Emails dated January 27, March 21 and 22, April 7, May 3 and June 8, 2006 between Jeff Stice and

Costco regarding the upcoming transition program by
Applicant of ESSENZA candles; and

(viii) Applicant/Costco Item Agreement Quote Form
for the ESSENZA Candle Four Pack Set dated March 28, 2006.

Also submitted with these interrogatory responses
and identifying ESSENZA products sold by AOR is an AOR
sales order catalogue revised in October 2005 including the
"Color & Fragrance Collection," "Color Collection Unscented
Tapers," "Fall Holiday '05," the "Botanical Collection,"
"Aromatherapy of Rome," the "Cucina Collection," the
"Garden Collection," the "Soy Collection," "Essenza," the
"Yoga Collection (Goddess; Rituals; Zodiac)," cast aluminum
accessories and AOR solid perfumes. Some pages of the
catalogue indicate that they are pages printed off the
website at www.aromacandleandscent.com on September 14,
2005, and some pages of which bear copyright notices of
2004 or 2002.

(d) the identification of each document which
evidences or supports such claim of use as of that date.

Response: All documents referenced above, as well
as a document entitled "Retail & Vendor Partnership Manual"
dated September 1, 1997, a copy of which is being submitted
with these interrogatory responses; a document entitled

"Memo to Accounts Receivable" dated May 26, 2000, a copy of which is being submitted with these interrogatory responses; a document entitled "Aromatherapy of Rome / Central Castings & Hilite Merger" dated November 4, 1999, a copy of which is being submitted with these interrogatory responses; a document entitled "Important Notice to Wicks N Sticks Franchisees" dated pre-June 30, 1998, a copy of which is being submitted with these interrogatory responses; and an undated document entitled "Our Sincerest Apologies," a copy of which is being submitted with these interrogatory responses.

All of the foregoing documents were identified and produced for these responses by Jeff Stice - CEO, Olympic Mountain Products, 8655 South 208th Street, Kent, WA 98031, except for the specimens of use under Lanham Act 1A filed with the USPTO by AOR, which were printed from the USPTO TDR service.

2. Identify each product and/or service with which Applicant's mark has been (or is intended to be) used in the United States, and with respect to each such product and/or service identify:

(a) the period of time during which Applicant's mark has been used with said product and/or service (i.e.,

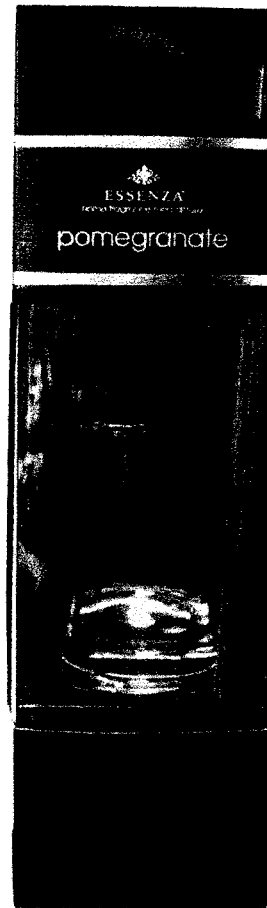
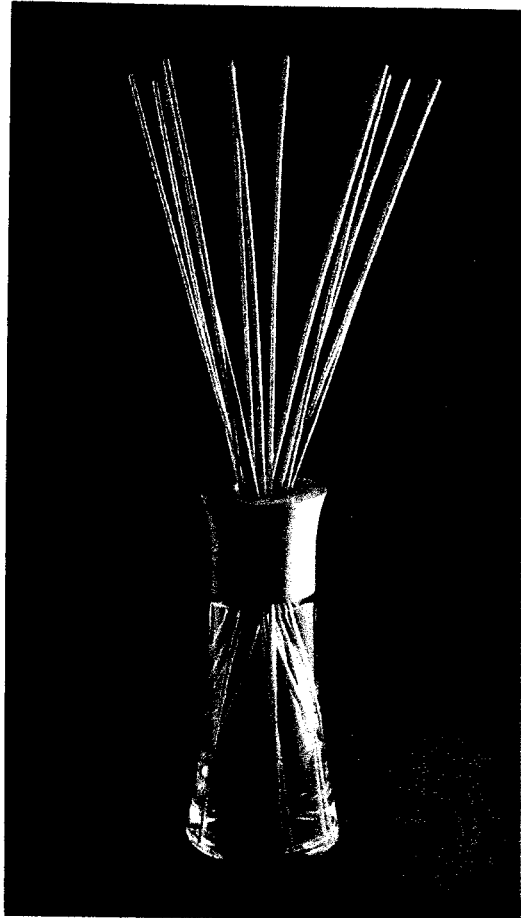
EXHIBIT C

OLYMPIC MOUNTAIN PRODUCTS

Phone: 1-800-

South 208th Street, Kent, WA 98031

A 352



Essenza 7.5oz Reed Diffusers with Wood Caps

Description	UPC # 034644-	Item #	Case Pack	Unit Cost	Case Cost
Firewood	323560	ES-323560	6	\$10.00	\$60.00
Vanilla Sunset	323577	ES-323577	6	\$10.00	\$60.00
Pomegranate	323584	ES-323584	6	\$10.00	\$60.00
Chai Spice	323591	ES-323591	6	\$10.00	\$60.00

Width=4.5" Depth=4.3125" Height=15" Cube=0.168 Weight=1.65 lbs

OLYMPIC MOUNTAIN PRODUCTS

Phone: 253-850-2343 / Fax: 253-850-3545
8655 So. 208th St. Kent, WA 98031

EXHIBIT D

which are outlets for Applicant's ESSENZA products. In addition to this, Applicant now sells its ESSENZA products at the trade shows listed above.

Applicant uses the services of the following individuals to sell its ESSENZA products: Jeff Stice - CEO, Ryan Porter - Sales, and Sharee Thompson - Sales, Olympic Mountain Products, 8655 South 208th Street, Kent, WA 98031.

All of the foregoing materials were identified and produced by Jeff Stice - CEO, Olympic Mountain Products, 8655 South 208th Street, Kent, WA 98031.

6. For each product and service in connection with which Applicant is using (or intends to use) Applicant's mark, identify, in detail, the channels of trade through which such products and/or services have been, are, or are intended to be sold and/or rendered, including but not limited to a general description of the type of customers to whom Applicant (intends to) advertises, promotes, and/or sells Applicant's products and/or services in connection with Applicant's mark. To the extent that your answer is different between the use of Applicant's Mark and the intended use of Applicant's Mark, your answer should so state, separately identifying the requested information.

Response: Department stores, wholesale clubs, gift stores, hardware stores, grocery stores and the World Wide Web. In addition to the documents already identified and produced above, a 2005 Report/Customer Analysis of Aroma Scent and Candle Company is being submitted with these interrogatory responses showing trade channels used at that time for ESSENZA products.

Though the foregoing trade channels are the types of customers to which Applicant markets its ESSENZA products, to the extent the interrogatory seeks identification of the type of ultimate customer of Applicant's ESSENZA products, such customers would tend to be primarily women 35 to 55 years old with mid- to high-income, and holiday shoppers looking for high-end home gift products.

7. Identify each agreement, assignment, license, contract, consent grant, or transfer of rights which concerns, refers or relates to Applicant's mark and/or any rights in connection with such mark.

Response: These documents were identified and produced in response to Interrogatory #1.

8. (a) Identify each person who participated in the selection, creation, and/or decision to adopt and/or to use Applicant's mark; and

EXHIBIT E

Response: Department stores, wholesale clubs, gift stores, hardware stores, grocery stores and the World Wide Web. In addition to the documents already identified and produced above, a 2005 Report/Customer Analysis of Aroma Scent and Candle Company is being submitted with these interrogatory responses showing trade channels used at that time for ESSENZA products.

Though the foregoing trade channels are the types of customers to which Applicant markets its ESSENZA products, to the extent the interrogatory seeks identification of the type of *ultimate* customer of Applicant's ESSENZA products, such customers would tend to be primarily women 35 to 55 years old with mid- to high-income, and holiday shoppers looking for high-end home gift products.

7. Identify each agreement, assignment, license, contract, consent grant, or transfer of rights which concerns, refers or relates to Applicant's mark and/or any rights in connection with such mark.

Response: These documents were identified and produced in response to Interrogatory #1.

8. (a) Identify each person who participated in the selection, creation, and/or decision to adopt and/or to use Applicant's mark; and

Response: Robert Schwei, c/o True Labs, Seattle, WA; Spencer Krenke, c/o True Labs, Seattle, WA; Jeff Stice - CEO, Olympic Mountain Products, 8655 South 208th Street, Kent, WA 98031; Joshua Fetveit - Graphic Design, Olympic Mountain Products, 8655 South 208th Street, Kent, WA 98031; Laurie Severe - Accounting, 32454 46th Place, South Auburn, WA 98001.

(b) Describe in detail the reasons for and/or relating to the selection and adoption of Applicant's mark, and the date of such selection/adoption.

Response: The ESSENZA mark was conceived and created in 1997 by AOR to underscore the company's commitment to the use of essential oils in its candle products. AOR's overall positioning for its ESSENZA line was the connection to scented products and aromatherapy (as reflected in the company's name), and to an upscale product (as reflected in the selection and adoption of a mark, ESSENZA, suggesting high-quality essential oils). The typeface and vase and ribbons logo used in connection with the ESSENZA mark were consistent through the time the mark was acquired by Applicant, and carry an upscale connotation. When Applicant purchased the ESSENZA mark and accompanying business in 2005, Applicant's intention was to

continue all of this positioning. Applicant has in fact followed through on maintaining the positioning of the ESSENZA mark and business through today, and continues to use the same typeface and vase and ribbons logo as first used by AOR in 1997, not only on candle products, but also on the related scented oil and diffuser products covered by the Application at issue in this proceeding.

9. (a) Identify all persons employed by Applicant, and/or persons affiliated with, or contracted by Applicant, responsible for advertising Applicant's mark and/or the goods/services sold or are intended to be sold under Applicant's mark; and

Response: (b) Identify the person(s) responsible for, or if there is no such person, with the most knowledge of, the marketing of services or goods offered for sale under or in connection with Applicant's mark. (As used in this interrogatory, the term "marketing" includes but is not limited to, the customers, channels of trade, and type(s) of outlets where such goods are or will be offered for sale and/or sold.

Response: Jeff Stice - CEO, Olympic Mountain Products, 8655 South 208th Street, Kent, WA 98031; Joshua Feitveit - Graphic Design, Olympic Mountain Products, 8655

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

LA SENZA CORP.,

Opposer,

v.

**OLYMPIC MOUNTAIN AND
MARINE PRODUCTS, INC.**

Applicant.

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Opp. No. 91185325

DECLARATION OF PHILIP A. KANTOR

Philip A. Kantor, under penalty of perjury, declares as follows:

1. I am an attorney duly admitted to practice in New York and Nevada. I am counsel of record for Applicant in this proceeding. I submit this Declaration in support of Applicant's Motion for Leave to Amend and for Summary Judgment. I have personal knowledge of the matters described in this Declaration.

2. Ex. 1 contains the records maintained by the United States Patent & Trademark Office ("USPTO"), as personally printed out by me from the USPTO website on September 27, 2009, of Registration No. 2,184,021, ESSENZA for candles. This registration was most recently owned by Applicant Olympic Mountain and Marine Products, Inc. ("Olympic"), but was cancelled on May 16, 2009, because former counsel for Olympic inadvertently failed to notify Applicant of the need to submit a Declaration under Section 8 of the Lanham Act and, consequently, no declaration was submitted to the USPTO. In fact, Applicant has at all applicable times continuously used the mark ESSENZA for candles in interstate commerce.

3. Upon discovering the inadvertent cancellation of Registration No. 2,184,021, I instructed Applicant to immediately arrange for the filing of a “replacement” application covering ESSENZA for candles, and such an application was filed on June 17, 2009. This second application bears Serial No. 77/762,421, and is ESSENZA for candles based on a date of first use in interstate commerce of March 1, 1997. Ex. 2 contains the records maintained by the USPTO, as personally printed out by me from the USPTO website on September 27, 2009, of Serial No. 77/762,421.

4. Ex. 3 contains the home page of Opposer La Senza Corp. (“La Senza”), as personally printed out by me on September 27, 2009, from the website at www.lasenza.com, specifically at www.lasenza.com/.

5. Ex. 4 contains the “About La Senza” page, as personally printed out by me on September 27, 2009, from the website at www.lasenza.com, specifically at www.lasenza.com/eng/aboutUs/aboutLaSenza.cfm.

6. Ex. 5 contains the records of the USPTO for the Declaration Under Section 8 for Registration No. 1,800,379, LA SENZA for “conditioners and skin moisturizing creams, toilet soaps, body, hand and face lotions as well as make-up bags sold empty,” signed by Irving Teitelbaum, Chairman of the Board on October 20, 1999, as personally printed out by me from the USPTO website on September 27, 2009.

7. Ex. 6 contains the records of the USPTO for the Combined Declaration of Use in Commerce/Application for Renewal for Registration No. 1,800,379, LA SENZA for “body lotions,” signed by Laurence Lewin, President on

October 16, 2003, as personally printed out by me from the USPTO website on September 27, 2009.

8. Ex. 7 contains the records of the USPTO for the Notice of Acceptance/Notice of Renewal for Registration No. 1,800,379, dated January 10, 2004, as personally printed out by me from the USPTO website on September 27, 2009.

9. Ex. 8 contains the records maintained by the USPTO, as personally printed out by me from the USPTO website on September 27, 2009, of Registration No. 1,800,379, as the registration currently appears in USPTO records, namely, showing goods in Class 018 as being cancelled.

10. Though Serial No. 77/071,961 does not show a translation of Olympic's ESSENZA mark, translation of the mark was required by the Examining attorney and provided by former counsel to the Examining attorney in the Response dated May 1, 2007 to an Office action dated April 19, 2007. The translation made of record in the Response is "essence." Ex. 9 contains the records of the May 1, 2007 Response as maintained by the USPTO, and as personally printed out by me from the USPTO website on September 21, 2007.

11. Ex. 10 contains a feature article entitled "La Senza Corporation," as personally printed out by me on September 25, 2009 from the website at www.fundinguniverse.com, specifically at www.fundinguniverse.com/company-histories/La-Senza-Corporation-Company-History.html.

12. Ex. 11 contains the records maintained by the USPTO, as personally printed out by me from the USPTO website on September 29, 2009, of Serial

No. 76/172,127, LA SENZA LINGERIE and design for, among other things, “massage oils.” This application was abandoned on August 26, 2003 without any allegation of use.

13. Ex. 12 contains the records maintained by the USPTO, as personally printed out by me from the USPTO website on September 29, 2009, of Serial No. 76/173,653, LA SENZA AQUA for, among other things, “massage oil” and “body oil.” This application was abandoned on August 8, 2002 without any allegation of use.

14. Ex. 13 contains the records maintained by the USPTO, as personally printed out by me from the USPTO website on September 29, 2009, of Serial No. 76/542,041, LA SENZA SPA for, among other things, “oils.” This application was abandoned on September 19, 2005 without any allegation of use.

15. Ex. 14 contains the records maintained by the USPTO, as personally printed out by me from the USPTO website on September 29, 2009, of Serial No. 77/648,660, LOVE LA SENZA for, among other things, “a weekend kit containing warming massage oil.” This application was filed on January 13, 2009, based on a priority date of July 17, 2008, and is thus junior to Olympic’s filing date and use under Serial No. 77/071,961.

16. Ex. 15 contains the results page of a keyword search as personally performed by me on September 27, 2009 at the www.lasenza.com website, and personally printed out by me on September 27, 2009 from the website at www.lasenza.com, specifically at www.lasenza.com/?loggedin=false&keywords=message+oil&isKeywordSearch=true&srccGo=Search. The keyword search performed was “massage oil” appearing anywhere in

the website at www.lasenza.com. The results page shows “[t]here were no products that contained all of the words you searched for. The below results contain some of the words.” Three results, sorted by relevance, are shown on the results page.

17. Ex. 16 contains the results page of a keyword search as personally performed by me on September 27, 2009 at the www.lasenza.com website, and personally printed out by me on September 27, 2009 from the website at www.lasenza.com, specifically at www.lasenza.com/?loggedin=false&keywords=bath+oil&isKeywordSearch=true&srcGo=Search. The keyword search performed was “bath oil” appearing anywhere in the website at www.lasenza.com. The results page shows “[t]here were no products that contained all of the words you searched for. The below results contain some of the words.” Six results, sorted by relevance, are shown on the results page.

18. Ex. 17 contains the results page of a keyword search as personally performed by me on September 27, 2009 at the www.lasenza.com website, and personally printed out by me on September 27, 2009 from the website at www.lasenza.com, specifically at www.lasenza.com/?loggedin=false&keywords=body+oil&isKeywordSearch=true&srcGo=Search. The keyword search performed was “body oil” appearing anywhere in the website at www.lasenza.com. The results page shows “[t]here were no products that contained all of the words you searched for. The below results contain some of the words.” Two results, sorted by relevance, are shown on the results page.

19. Ex. 18 contains the results page of a keyword search as personally performed by me on September 27, 2009 at the www.lasenza.com website, and

personally printed out by me on September 27, 2009 from the website at www.lasenza.com, specifically at www.lasenza.com/?language=en&loggedin=false&keywords=scented+candles&isKeywordSearch=true. The keyword search performed was “scented candles” appearing anywhere in the website at www.lasenza.com. Twelve results, sorted by relevance, are shown on the results page.

20. Ex. 19 contains a complete copy of the Trademark Trial & Appeal Board opinion in *In re Kastle Systems, Inc.*, Serial Nos. 332,494 and 332,495, dated November 30, 1984, as personally printed out by me on September 29, 2009 from records for the above serial numbers on the USPTO website.

21. Ex. 20 contains a complete copy of the Trademark Trial & Appeal Board opinion in *In re Zolo Technologies, Inc.*, Serial Nos. 76/035,119, 76/035,120 and 76/035,301, dated August 13, 2002, as personally printed out by me on September 29, 2009 from records for the above serial numbers on the USPTO website.

22. Ex. 21 contains a complete copy of the Trademark Trial & Appeal Board opinion in *In re Beauty FX, Inc.*, Serial No. 76/238,909, dated June 12, 2003, as personally printed out by me on September 29, 2009 from records for the above serial numbers on the USPTO website.

23. The accompanying memorandum of law cites a Trademark Trial & Appeal Board opinion dismissing the opposition in a case entitled *Champagne Louis Roederer, S.A. v. Delicato Vineyards*, Opposition No. 91/080,932, dated June 25, 1997. Despite diligent effort, I have been unable to find a copy of the opinion anywhere on the

USPTO website, whether through the USPTO's TTABVUE system or decisions of the TTAB. Ex. 22 contains the complete docket of the opposition proceeding from the TTABVUE service, personally printed out by me from the USPTO website on September 29, 2009. This printout shows that none of the documents from the opposition proceeding are available online (the TTAB opinion dismissing the opposition is Docket #60).

24. The *Champagne Louis Roederer* decision nowhere states that it is not citable precedent of the TTAB. However, searching by date through TTAB decisions, I was able to locate a reference to the decision, though not a copy of the opinion. See, Ex. 23. This reference shows the decision as not constituting citable precedent of the TTAB. However, the decision was subsequently affirmed in a published decision of the Court of Appeals for the Federal Circuit. 148 F.3d 1373, 47 U.S.P.Q.2d 1459 (Fed. Cir. 1998). Accordingly, the decision is treated as citable in the accompanying memorandum.

25. Since the memorandum quotes a portion of the Board's opinion, setting forth the Board's reasoning for holding no likelihood of confusion, a copy of the opinion appearing at 1997 TTAB Lexis 61 has been annexed as Ex. 24. I have been able to find no other source for a copy of the Board's opinion.

I declare under penalty of perjury under the laws of the United States that the foregoing is true and correct.

September 29, 2009


Philip A. Kantor

EXHIBIT 1

**United States Patent and Trademark Office**

Home | Site Index | Search | FAQ | Glossary | Guides | Contacts | eBusiness | eBiz alerts | News | Help

Trademarks > Trademark Electronic Search System (TESS)

TESS was last updated on Sat Sep 26 04:01:51 EDT 2009

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Record 1 out of 1
[TARR Status](#)
[ASSIGN Status](#)
[TDR](#)
[TTAB Status](#) (Use the "Back" button of the Internet Browser to return to TESS)
Typed Drawing

Word Mark	ESSENZA
Translations	The English translation of "ESSENZA" is "essence".
Goods and Services	(CANCELLED) IC 004. US 001 006 015. G & S: candles. FIRST USE: 19970301. FIRST USE IN COMMERCE: 19970301
Mark Drawing Code	(1) TYPED DRAWING
Serial Number	75334697
Filing Date	July 31, 1997
Current Filing Basis	1A
Original Filing Basis	1A
Published for Opposition	June 2, 1998
Registration Number	2184021
Registration Date	August 25, 1998
Owner	(REGISTRANT) Aromatherapy of Rome, The CORPORATION TEXAS 502 Old Thorndale Rd. Taylor TEXAS 76574
	(LAST LISTED OWNER) OLYMPIC MOUNTAIN AND MARINE PRODUCTS, INC. DBA OLYMPIC MOUNTAIN PRODUCTS CORPORATION 8655 S 208TH STREET KENT WASHINGTON 98031
Assignment Recorded	ASSIGNMENT RECORDED
Attorney of Record	JESSICA STONE LEVY
Type of Mark	TRADEMARK
Register	PRINCIPAL
Affidavit Text	SECT 15. SECT 8 (6-YR).
Live/Dead Indicator	DEAD
Cancellation Date	May 16, 2009

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Thank you for your request. Here are the latest results from the TARR web server.

This page was generated by the TARR system on 2009-09-27 14:24:36 ET

Serial Number: 75334697 Assignment Information Trademark Document Retrieval

Registration Number: 2184021

Mark (words only): ESSENZA

Standard Character claim: No

Current Status: Registration canceled under Section 8.

Date of Status: 2009-05-16

Filing Date: 1997-07-31

Transformed into a National Application: No

Registration Date: 1998-08-25

Register: Principal

Law Office Assigned: LAW OFFICE 105

If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at TrademarkAssistanceCenter@uspto.gov

Current Location: 830 -Post Registration

Date In Location: 2005-04-22

LAST APPLICANT(S)/OWNER(S) OF RECORD

1. OLYMPIC MOUNTAIN AND MARINE PRODUCTS, INC.

DBA/AKA/TA/Formerly: DBA OLYMPIC MOUNTAIN PRODUCTS

Address:

OLYMPIC MOUNTAIN AND MARINE PRODUCTS, INC.

8655 S 208TH STREET

KENT, WA 98031

United States

Legal Entity Type: Corporation

State or Country of Incorporation:(NOT AVAILABLE)

GOODS AND/OR SERVICES

International Class: 004
Class Status: Section 8 - Cancelled
candles
Basis: 1(a)
First Use Date: 1997-03-01
First Use in Commerce Date: 1997-03-01

ADDITIONAL INFORMATION

Translation: The English translation of "ESSENZA" is "essence".

MADRID PROTOCOL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

NOTE: To view any document referenced below, click on the link to "Trademark Document Retrieval" shown near the top of this page.

2009-05-16 - Canceled Section 8 (10-year)/Expired Section 9
2006-12-27 - Automatic Update Of Assignment Of Ownership
2006-09-28 - Review Of Correspondence Complete
2005-05-05 - PAPER RECEIVED
2005-04-22 - Section 8 (6-year) accepted & Section 15 acknowledged
2005-04-04 - Response received to Post Registration action - Sections 8 & 15
2005-04-04 - PAPER RECEIVED
2004-10-05 - Post Registration action mailed Section 8 & 15
2004-08-19 - Section 8 (6-year) and Section 15 Filed
2004-08-19 - TEAS Section 8 & 15 Received
1998-08-25 - Registered - Principal Register
1998-06-02 - Published for opposition
1998-05-01 - Notice of publication
1998-03-25 - Approved for Pub - Principal Register (Initial exam)
1998-03-18 - Examiner's amendment mailed

1998-03-12 - Assigned To Examiner

ATTORNEY/CORRESPONDENT INFORMATION

Attorney of Record

JESSICA STONE LEVY

Correspondent

JESSICA STONE LEVY
PRESTON GATES & ELLIS LLP
SUITE 2900 FOURTH AVENUE
SEATTLE WA 98104

EXHIBIT 2



United States Patent and Trademark Office

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Trademarks > Trademark Electronic Search System (TESS)

TESS was last updated on Sat Sep 26 04:01:51 EDT 2009

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[FIRST DOC](#) [PREV DOC](#) [NEXT DOC](#) [LAST DOC](#) Please logout when you are done to release system resources allocated for you. List At: OR to record: **Record 1 out of 3**[TARR Status](#) [ASSIGN Status](#) [TDR](#) [TTAB Status](#) (Use the "Back" button of the Internet Browser to return to TESS)

ESSENZA

Word Mark	ESSENZA
Translations	The English translation of essenza in the mark is essence.
Goods and Services	IC 004. US 001 006 015. G & S: Candles . FIRST USE: 19970301. FIRST USE IN COMMERCE: 19970301
Standard Characters Claimed	
Mark Drawing Code	(4) STANDARD CHARACTER MARK
Serial Number	77762421
Filing Date	June 17, 2009
Current Filing Basis	1A
Original Filing Basis	1A
Owner	(APPLICANT) Olympic Mountain and Marine Products, Inc. DBA Olympic Mountain Products CORPORATION WASHINGTON 8655 S 208th St Kent WASHINGTON 98031
Attorney of Record	Clark A. Puntigam
Type of Mark	TRADEMARK
Register	PRINCIPAL
Live/Dead Indicator	LIVE

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Serial Number: 77762421 Assignment Information Trademark Document Retrieval

Registration Number: (NOT AVAILABLE)

Mark

ESSENZA

(words only): ESSENZA

Standard Character claim: Yes

Current Status: Approved by the examining attorney for publication for opposition. This is NOT the beginning of the Opposition period. In approximately two months, please visit the web site to learn the actual date of publication for opposition in the Trademark Official Gazette.

Date of Status: 2009-09-16

Filing Date: 2009-06-17

Transformed into a National Application: No

Registration Date: (DATE NOT AVAILABLE)

Register: Principal

Law Office Assigned: LAW OFFICE 111

Attorney Assigned:
LEHKER DAWN FELDMAN

Current Location: M2X -TMO Law Office 111 - Examining Attorney Assigned

Date In Location: 2009-09-16

LAST APPLICANT(S)/OWNER(S) OF RECORD

1. Olympic Mountain and Marine Products, Inc.

DBA/AKA/TA/Formerly: DBA Olympic Mountain Products
Address:

Olympic Mountain and Marine Products, Inc.
8655 S 208th St
Kent, WA 98031
United States
Legal Entity Type: Corporation
State or Country of Incorporation: Washington

GOODS AND/OR SERVICES

International Class: 004
Class Status: Active
Candles
Basis: 1(a)
First Use Date: 1997-03-01
First Use in Commerce Date: 1997-03-01

ADDITIONAL INFORMATION

Translation: The English translation of essenza in the mark is essence.

MADRID PROTOCOL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

NOTE: To view any document referenced below, click on the link to "Trademark Document Retrieval" shown near the top of this page.

2009-09-16 - Approved for Pub - Principal Register (Initial exam)
2009-09-16 - Assigned To Examiner
2009-06-22 - New Application Office Supplied Data Entered In Tram
2009-06-20 - New Application Entered In Tram

ATTORNEY/CORRESPONDENT INFORMATION

Attorney of Record
Clark A. Puntigam

Correspondent
CLARK A. PUNTIGAM
JENSEN & PUNTIGAM, P.S.
2033 6TH AVE STE 1020
SEATTLE, WA 98121-2527

Phone Number: 206-448-3200

Fax Number: 206-441-5514

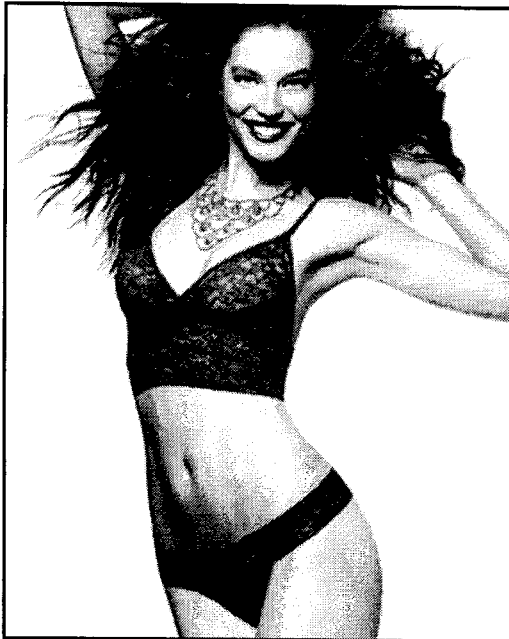
EXHIBIT 3

US

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EXHIBIT 4

US

Sign In | My Account | **View My Cart (0 items)**

Keyword or Style # **SEARCH**

BRAS | **PANTIES** | **SEXY LINGERIE** | **SLEEP & LOUNGE** | **ACCESSORIES** | **LA SENZA SPIRIT** | **SALE & SPECIALS** | **COLLECTIONS**

Customer Service > About La Senza

ORDERING ON LASENZA.COM

Placing an Order
Changes or Cancellations
Express Checkout
Gift Purchases
Taxes
Prestige Loyalty Cards

LASENZA.COM FEATURES

Promotional Offers
Sharing a Product

KNOW LASENZA.COM

Size Charts
Why Shop at Lasenza.com
What is Lasenzaspirit.com
Getting Around the Site
Garment Glossary

BILLING AND SHIPPING

Shipping Fees
Payment Declines
Delivery Estimated Dates
Tracking Your Package
Undeliverable Packages
Shipping Restrictions

EXCHANGES AND RETURNS

Return Policies
Gift Returns
Refunds
Exchanges

SECURITY AND PRIVACY

Privacy Policy
Legal Terms
Security Statement
Technical Specifications

ACCOUNT INFORMATION

What is an Account?
Changing Your Information
Address Book
Closing Your Account
Email Club Settings

La Senza Lingerie is the ultimate shopping destination for a vast array of exclusive high quality branded lingerie at affordable prices.

Our mission is to provide an outstanding lingerie presentation in a world class environment. La Senza provides customers with outstanding personal service, while combining quality, fit and value. The merchandise continues to satisfy two areas of consumer needs: firstly, La Senza strives to become the destination specialty lingerie store for all consumers and secondly, to provide a constant range of merchandise relevant to the gift purchaser.

Since the first store opening in 1990, La Senza has maintained a focused vision of excellence. The La Senza brand name has become synonymous with high quality, affordability and elegance, and La Senza takes pride in dedicating itself to its customers and merchandise.

As Canada's premier lingerie retailer, La Senza owns and operates over 300 stores throughout Canada, and a further 300 stores in 30 more countries around the world.

La Senza offers women a unique shopping experience with outstanding lingerie presentation in a beautiful and intimate environment, featuring everything from bras & panties, to sleepwear, loungewear, bodycare, and accessories.

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EXHIBIT 5



PRU

10-25-1999

U.S. Patent & TMOic/TM Mail Rcpt Dt. #11

TRADEMARK

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Mark: **LA SENZA**

Registration No.: **1,800,379**

Issued: **October 26, 1993**

DECLARATION UNDER SECTION 8

IRVING TEITELBAUM declares that he is the Chairman of the Board of **LA SENZA** INC., and authorized to make this declaration as an officer of and on behalf of said corporation, a corporation duly organized and existing under the laws of Canada, located at 1370 Dundas Street East, Suite 210, Mississauga, Ontario, Canada, L4Y 4G4; that the said corporation is the owner of Registration no. 1,800,379 issued October 26, 1993, as evidenced by the Patent and Trademark Office records; that the mark shown therein is currently in use by the Registrant, in foreign commerce between Canada and the United States and/or in interstate commerce in the United States, in connection with the following goods, namely: **CONDITIONERS AND SKIN MOISTURIZING CREAMS, TOILET SOAPS, BODY, HAND AND FACE LOTIONS AS WELL AS MAKE-UP BAGS SOLD EMPTY**; that the mark is still in use in such commerce as evidenced by the attached specimen(s) showing the mark as now in use in connection with the above identified goods; that there has been no final decision adverse to Registrant's claim of ownership of such mark for such goods or its right to register the same or maintain the same on the Register; that there is no proceeding involving any of said rights pending in the Patent and Trademark Office or in a Court; and not finally disposed of; that all statements made herein of his own knowledge are true and all statements made on information and belief are believed to be true; and further, that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false

#309668.01

10/26/1999 FMAX1 0000226 1800379

100.00 0P

01 FC:372

statements may jeopardize the validity of this declaration and the registration to which it relates.

The law firm of JACOBSON, PRICE, HOLMAN & STERN, PLLC., whose postal address is 400 Seventh Street, N.W., Washington, D.C. 20004-2201, is hereby designated Applicant's Domestic Representative upon whom notices or process in proceedings affecting the mark may be served.

Registrant hereby appoints **SIMOR L. MOSKOWITZ**, HARVEY B. JACOBSON, JR., D. DOUGLAS PRICE, JOHN CLARKE HOLMAN, MARVIN R. STERN, MICHAEL R. SLOBASKY, MARSHA G. GENTNER, JONATHAN L. SCHERER, IRWIN M. AISENBERG, WILLIAM E. PLAYER and YOON S. HAM, its attorneys, to file this declaration and to transact all business in the Patent and Trademark Office in connection therewith. Please address all correspondence to JACOBSON, PRICE, HOLMAN & STERN, PLLC., 400 Seventh Street, N.W., Washington, DC 20004.

LA SENZA INC.

By: 

Printed Name: Irving Teitelbaum

Title: Chairman of the Board

Date: October 20, 1999

Attorney Docket No.: 1432/T-13183

Declaration Under §8
Mark: LA SENZA
RN: 1,800,379
Issued October 26, 1993
Registrant: La Senza, Inc.
T 13183

lotion pour le corps

buddy lotion

relax



EXHIBIT 6

TRADEMARKS 16

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Registration of:

La Senza Inc.

Registration No.: 1,800,379

Registered: October 26, 1993

Mark: LA SENZA

**COMBINED DECLARATION OF USE IN COMMERCE/APPLICATION
FOR RENEWAL**

La Senza Inc. is a corporation duly organized and existing under the laws of Canada, located and doing business at 1370 Dundas Street East, Suite 210, Mississauga, Ontario, Canada L4Y 4G4.

The owner is using the above-identified mark in commerce on or in connection with the following goods listed in the existing registration, namely: **BODY LOTIONS**.

The owner is using the mark in commerce on or in connection with the goods identified above, as evidenced by the attached specimen(s) showing the mark as currently used in commerce.

The registrant requests that the registration be renewed for the goods identified in the registration.

The law firm of JACOBSON HOLMAN PLLC, whose postal address is 400 Seventh Street, N.W., Washington, D.C. 20004-2201, is hereby designated Applicant's Domestic Representative upon whom notices or process in proceedings affecting the mark may be served.

11/10/2003 SWILSON1 00000104 1800379

01 FC:6205
02 FC:6201

100.00 DP
400.00 DP

Please recognize **SIMOR L. MOSKOWITZ, HARVEY B. JACOBSON, JR., JOHN CLARKE HOLMAN, MARVIN R. STERN, ALLEN S. MELSER, MICHAEL R. SLOBASKY, MARSHA G. GENTNER, JONATHAN L. SCHERER, IRWIN M. AISENBERG, GEORGE W. LEWIS, WILLIAM E. PLAYER, YOON S. HAM and NATHANIEL A. HUMPHRIES** as the attorneys representing the above-identified Applicant in all matters associated with the above-identified registration. Please address all correspondence to CUSTOMER NO. 00136 or the law firm of JACOBSON HOLMAN PLLC, The Jenifer Building, 400 Seventh Street, N.W., Washington, D.C. 20004-2201.

The undersigned, being hereby warned that willful false statements and the like are punishable by fine or imprisonment, or both, under 18 U.S.C. § 1001, and that such willful false statements and the like may jeopardize the validity of this document, declares that he/she is properly authorized to execute this document on behalf of the Owner; and all statements made of his/her own knowledge are true and that all statements made on information and belief are believed to be true.

LA SENZA INC.

By: _____

Name: _____

Title: _____

Date: October 16, 2003
Attorney Docket No.: T-13183



Incoming Correspondence Routing Sheet

To: Post Registration (PRU)

Word Mark: LA SENZA

Reg. No.: 1800379



Serial No: 74121287



Mail Date: 10222003



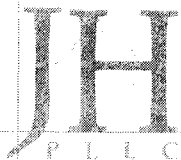
Doc. Type: Combined Section 8 and 9



Fee

RAM Mail Date: 102203





Law Offices
Jacobson Holman
Professional Limited Liability Company
400 Seventh Street, N.W.
Washington, D.C. 20004-2218

(202) 638-6666
(202) 393-5350/51/52 (fax)
www.jhpllc.com
Firm e-mail: jh@jhpllc.com

October 22, 2003

Commissioner for Trademarks
2900 Crystal Drive
Arlington, Virginia 22202-3514

Box POST REG FEE

Re: U.S. Registration No. 1,800,379
Mark: **LA SENZA**
Registrant: La Senza Inc.
Our Reference: T13183

Sir:

We enclose the following for filing in the Patent and Trademark Office:

- ☐ Application for trademark registration, formal drawing, and:
- ☐ Specimens.
 - ☐ Certified Copy (and translation) of foreign registration.
 - ☐ USE IN COMMERCE basis.
 - ☐ Section 44 (d) priority basis.
 - ☐ Section 44 (e) foreign registration basis.
 - ☐ INTENT TO USE basis.
- ☐ Declaration under Section 8 with specimen(s)
- ☐ Combined Declarations under Sections 8 and 15 with specimen(s)
- ☒ Combined Declaration/Application for Renewal with specimen(s)

Also, enclosed is our check for the required filing fee in the amount of \$500.00. Should this check become detached, or the amount be insufficient, please charge our Deposit Account, No. 06-1358.

Respectfully submitted,

JACOBSON HOLMAN PLLC

By: 

Simor L. Moskowitz
Attorney for Correspondence



10-22-2003

U.S. Patent & TMO/TM Mail Rpt Dt: #64

SLM/dlj
Enclosures

Harvey G. Jacobson, Jr. John Clarke Holman Simor L. Moskowitz Allen S. Melsor Michael R. Siobasky Marsha G. Gentler Kathleen L. Scherer
Irwin H. Aisenberg George W. Lewis William E. Payer Yoon S. Ham Philip L. O'Neill
Linda J. Shapiro Leesa N. Weiss Suzin C. Bailey Matthew J. Cuccios Daniel K. Dorsay Suzanne K. Sundby*
Of Counsel: Marvin R. Stern Nathaniel A. Humphries

* Bar other than D.C.

EXHIBIT 7

Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3514
www.uspto.gov

REGISTRATION NO: 1800379 SERIAL NO: 74/121287 MAILING DATE: 01/10/2004
REGISTRATION DATE: 10/26/1993
MARK: LA SENZA
REGISTRATION OWNER: LA SENZA INC.

CORRESPONDENCE ADDRESS:

SIMOR L. MOSKOWITZ
JACOBSON, HOLMAN PLLC
THE JENIFER BUILDING
400 SEVENTH STREET, N.W.
WASHINGTON, D.C. 200042201

NOTICE OF ACCEPTANCE

15 U.S.C. Sec. 1058(a)(3)

THE COMBINED AFFIDAVIT AND RENEWAL APPLICATION FILED FOR THE ABOVE-IDENTIFIED REGISTRATION MEETS THE REQUIREMENTS OF SECTION 8 OF THE TRADEMARK ACT, 15 U.S.C. Sec. 1058. **ACCORDINGLY, THE SECTION 8 AFFIDAVIT IS ACCEPTED.**

NOTICE OF RENEWAL

15 U.S.C. Sec. 1059(a)

THE COMBINED AFFIDAVIT AND RENEWAL APPLICATION FILED FOR THE ABOVE-IDENTIFIED REGISTRATION MEETS THE REQUIREMENTS OF SECTION 9 OF THE TRADEMARK ACT, 15 U.S.C. Sec. 1059. **ACCORDINGLY, THE REGISTRATION IS RENEWED.**

THE REGISTRATION WILL REMAIN IN FORCE FOR CLASS(ES):
003, 018.

WEST, JOYCE M
PARALEGAL SPECIALIST
POST-REGISTRATION DIVISION
(703)308-9500

**PLEASE SEE THE REVERSE SIDE OF THIS NOTICE FOR INFORMATION
CONCERNING REQUIREMENTS FOR MAINTAINING THIS REGISTRATION**
ORIGINAL

REQUIREMENTS FOR MAINTAINING A FEDERAL TRADEMARK REGISTRATION)
I) SECTION 8: AFFIDAVIT OF CONTINUED USE The registration shall remain in force for 10 years, except that the registration shall be canceled for failure to file an Affidavit of Continued Use under Section 8 of the Trademark Act, 15 U.S.C. Sec. 1058, at the end of each successive 10-year period following the date of registration. **Failure to file the Section 8 Affidavit will result in the cancellation of the registration.**
II) SECTION 9: APPLICATION FOR RENEWAL The registration shall remain in force for 10 years, subject to the provisions of Section 8,

except that the registration shall expire for failure to file an Application for Renewal under Section 9 of the Trademark Act, 15 U.S.C. Sec. 1059, at the end of each successive 10-year period following the date of registration. **Failure to file the Application for Renewal will result in the expiration of the registration.**

NO FURTHER NOTICE OR REMINDER OF THESE REQUIREMENTS WILL BE SENT TO THE REGISTRANT BY THE PATENT AND TRADEMARK OFFICE. IT IS RECOMMENDED THAT THE REGISTRANT CONTACT THE PATENT AND TRADEMARK OFFICE APPROXIMATELY ONE YEAR BEFORE THE EXPIRATION OF THE TIME PERIODS SHOWN ABOVE TO DETERMINE APPROPRIATE REQUIREMENTS AND FEES.

EXHIBIT 8



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Typed Drawing

Word Mark	LA SENZA
Translations	The word "LA" translates from Italian to the English word "the". The word "SENZA" translates from Italian to the English word "without".
Goods and Services	<p>IC 003. US 001 004 006 050 051 052. G & S: [perfume and cologne, cosmetics; namely, blush, eyebrow pencils, lipsticks, lip gloss, mascara, eyeliner, hair sprays,] conditioners and skin moisturizing creams; toilet soaps,[bath powder,] body, hand and face lotions, as well make-up bags sold empty. [shaving kits containing shaving cream, brushes, combs, and a razor and the case therefor]</p> <p>(CANCELLED) IC 008. US 023 028 044. G & S: [manicure sets, moustache kits comprising manicuring scissors and the case therefor]</p> <p>(CANCELLED) IC 018. US 001 002 003 022 041. G & S: [shoe and garment travel bags, make-up bags sold empty]</p> <p>(CANCELLED) IC 020. US 002 013 022 025 032 050. G & S: [clothes hangers]</p> <p>(CANCELLED) IC 031. US 001 046. G & S: [dried flowers]</p> <p>(CANCELLED) IC 042. US 100 101. G & S: [retail store services in the field of cosmetic and beauty/personal accessories]</p>
Mark Drawing Code	(1) TYPED DRAWING
Serial Number	74121287
Filing Date	November 30, 1990
Current Filing Basis	44E
Original Filing Basis	1B;44D
Published for Opposition	May 25, 1993
Change In Registration	CHANGE IN REGISTRATION HAS OCCURRED
Registration Number	1800379
Registration	

Date October 26, 1993

Owner (REGISTRANT) LA SENZA INC. CORPORATION CANADA 1370 DUNDAS STREET EAST SUITE 210
MISSISSAUGA, ONTARIO CANADA L4Y 4G4

(LAST LISTED OWNER) LA SENZA CORPORATION (3209893) CORPORATION UNDER THE NOVA SCOTIA
COMPANIES ACT CANADA 1608 ST. REGIS BLVD. DORVAL, QUEBEC CANADA H9P 1H6

Assignment Recorded ASSIGNMENT RECORDED

Attorney of Record Simor L. Moskowitz

Priority Date May 30, 1990

Type of Mark TRADEMARK. SERVICE MARK

Register PRINCIPAL

Affidavit Text PARTIAL SECT 8 (6-YR). SECTION 8(10-YR) 20040110.

Renewal 1ST RENEWAL 20040110

Live/Dead Indicator LIVE

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Serial Number: 74121287 Assignment Information Trademark Document Retrieval

Registration Number: 1800379

Mark (words only): LA SENZA

Standard Character claim: No

Current Status: This registration has been renewed.

Date of Status: 2004-01-10

Filing Date: 1990-11-30

Transformed into a National Application: No

Registration Date: 1993-10-26

Register: Principal

Law Office Assigned: LAW OFFICE 11

If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at TrademarkAssistanceCenter@uspto.gov

Current Location: 40S -Scanning On Demand

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LAST APPLICANT(S)/OWNER(S) OF RECORD

1. LA SENZA CORPORATION (3209893)

Address:

LA SENZA CORPORATION (3209893)

1608 ST. REGIS BLVD.

DORVAL, QUEBEC H9P 1H6

Canada

Legal Entity Type: CORPORATION UNDER THE NOVA SCOTIA COMPANIES ACT

State or Country Where Organized: Canada

GOODS AND/OR SERVICES

International Class: 003**Class Status:** Active

conditioners and skin moisturizing creams; toilet soaps, body, hand and face lotions, as well make-up bags sold empty.

Basis: 44(e)**First Use Date:** (DATE NOT AVAILABLE)**First Use in Commerce Date:** (DATE NOT AVAILABLE)**International Class: 008****Class Status:** Section 8 - Cancelled**Basis:** 44(e)**First Use Date:** (DATE NOT AVAILABLE)**First Use in Commerce Date:** (DATE NOT AVAILABLE)**International Class: 018****Class Status:** Section 8 - Cancelled**Basis:** 44(e)**First Use Date:** (DATE NOT AVAILABLE)**First Use in Commerce Date:** (DATE NOT AVAILABLE)**International Class: 020****Class Status:** Section 8 - Cancelled**Basis:** 44(e)**First Use Date:** (DATE NOT AVAILABLE)**First Use in Commerce Date:** (DATE NOT AVAILABLE)**International Class: 031****Class Status:** Section 8 - Cancelled**Basis:** 44(e)**First Use Date:** (DATE NOT AVAILABLE)**First Use in Commerce Date:** (DATE NOT AVAILABLE)**International Class: 042****Class Status:** Section 8 - Cancelled**Basis:** 44(e)**First Use Date:** (DATE NOT AVAILABLE)**First Use in Commerce Date:** (DATE NOT AVAILABLE)

ADDITIONAL INFORMATION

Translation: The word "LA" translates from Italian to the English word "the". The word "SENZA" translates from Italian to the English word "without".

Foreign Application Number: 658954**Foreign Registration Number:** TMA398210**Foreign Registration Date:** 1992-05-15**Country:** Canada**Foreign Filing Date:** 1990-05-30**Foreign Expiration Date:** 2007-05-15

MADRID PROTOCOL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

NOTE: To view any document referenced below, click on the link to "Trademark Document Retrieval" shown near the top of this page.

2008-05-14 - Automatic Update Of Assignment Of Ownership

2007-09-12 - Case File In TICRS

2004-01-10 - First renewal 10 year

2004-01-10 - Section 8 (10-year) accepted/ Section 9 granted

2003-10-22 - Combined Section 8 (10-year)/Section 9 filed

2000-03-23 - Partial Section 8 (6-year) accepted

1999-10-25 - Section 8 (6-year) filed

1993-10-26 - Registered - Principal Register

1993-09-09 - Notice of Allowance canceled

1993-09-09 - ITU claim deleted

1993-08-17 - Noa Mailed - SOU Required From Applicant

1993-05-25 - Published for opposition

1993-04-23 - Notice of publication

1993-03-09 - Approved for Pub - Principal Register (Initial exam)

1993-03-04 - Examiner's amendment mailed

1993-03-04 - Previous allowance count withdrawn

1993-02-08 - Communication received from applicant

1993-02-03 - Approved for Pub - Principal Register (Initial exam)

1992-05-03 - Communication received from applicant

1993-01-29 - Examiner's amendment mailed

1992-11-19 - Reinstated

1992-02-10 - Abandonment - Failure To Respond Or Late Response

1991-06-20 - Non-final action mailed

1991-03-19 - Assigned To Examiner

ATTORNEY/CORRESPONDENT INFORMATION

Attorney of Record

Simor L. Moskowitz

Correspondent

SIMOR L. MOSKOWITZ
JACOBSON, HOLMAN PLLC
THE JENIFER BUILDING
400 SEVENTH STREET, N.W.
WASHINGTON, D.C. 200042201

Domestic Representative

JACOBSON, HOLMAN PLLC

EXHIBIT 9

Document Description: Response to Office ActionMail / Create Date: **01-May-2007**[Previous Page](#)[Next Page](#)You are currently on page **1** of **2**

PTO Form 1957 (Rev 9/2005)

OMB No. 0651-0050 (Exp. 04/2009)

Response to Office Action**The table below presents the data as entered.**

Input Field	Entered
SERIAL NUMBER	77071961
LAW OFFICE ASSIGNED	LAW OFFICE 111
MARK SECTION (no change)	
ARGUMENT(S)	

In the action of April 19, 2007, the examiner found no similar registered or pending marks which would bar registration under the Trademark Act. The examiner further requested clarification of the identification of goods. Applicant adopts the identification of goods set forth herein for Class 21. This is a slight modification of the identification of goods suggested by the examiner. Approval of the identification of goods in Class 21 is respectfully requested.

Applicant further adds the goods set forth herein for Class 3.

Applicant further deletes the goods in Class 5.

The examiner further required a translation of a non-English word "essenza". The English translation of essenza is "essence".

This is believed to be a complete response to the examiner's action. Allowance of the application and passage of the mark to publication is respectfully requested.

Respectfully submitted,

Clark A. Puntigam

GOODS AND/OR SERVICES SECTION (005)(class deleted)

INTERNATIONAL CLASS	005
DESCRIPTION	
Oil diffusers and scented oils therefor to produce room aromas	
FILING BASIS	Section 1(b)
GOODS AND/OR SERVICES SECTION (021)(class added)Original Class (005)	
INTERNATIONAL CLASS	021
DESCRIPTION	
scent diffusers comprised of a container and wood rods used to diffuse oil scent poured in the container	
FILING BASIS	Section 1(b)
GOODS AND/OR SERVICES SECTION (003)(class added)	
INTERNATIONAL CLASS	003
DESCRIPTION	
Scented oils used to produce aromas when heated; essential oils for household use	
FILING BASIS	Section 1(b)
PAYMENT SECTION	
NUMBER OF CLASSES	1
FEE PER CLASS	325
TOTAL FEES DUE	325
SIGNATURE SECTION	
DECLARATION SIGNATURE	/clark a. puntigam/
SIGNATORY'S NAME	Clark A. Puntigam
SIGNATORY'S POSITION	Attorney of Record
DATE SIGNED	05/01/2007
RESPONSE SIGNATURE	/clark a. puntigam/
SIGNATORY'S NAME	Clark A. Puntigam
SIGNATORY'S POSITION	Attorney of Record
DATE SIGNED	05/01/2007
AUTHORIZED SIGNATORY	YES
FILING INFORMATION SECTION	
SUBMIT DATE	Tue May 01 15:21:41 EDT 2007
USPTO/ROA-64.221.36.243-2 0070501152141416377-77071	

TEAS STAMP

961-37082d99ada8c138c2a69
5b69f88e562c0-CC-99-20070
501151757395448

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OMB No. 0651-0050 (Exp. 04/2009)

Response to Office Action

To the Commissioner for Trademarks:

Application serial no. **77071961** has been amended as follows:

Argument(s)

In response to the substantive refusal(s), please note the following:

In the action of April 19, 2007, the examiner found no similar registered or pending marks which would bar registration under the Trademark Act. The examiner further requested clarification of the identification of goods. Applicant adopts the identification of goods set forth herein for Class 21. This is a slight modification of the identification of goods suggested by the examiner. Approval of the identification of goods in Class 21 is respectfully requested.

Applicant further adds the goods set forth herein for Class 3.

Applicant further deletes the goods in Class 5.

The examiner further required a translation of a non-English word "essenza". The English translation of essenza is "essence".

This is believed to be a complete response to the examiner's action. Allowance of the application and passage of the mark to publication is respectfully requested.

Respectfully submitted,

Clark A. Puntigam

Classification and Listing of Goods/Services

Applicant hereby deletes the following class of goods/services from the application.

Class 005 for Oil diffusers and scented oils therefor to produce room aromas

Applicant hereby adds the following class of goods/services to the application:

New:

Class 021 (Original Class: 005) for scent diffusers comprised of a container and wood rods used to diffuse oil scent poured in the container

Section 1(b), the applicant has a bona fide intention to use or use through the applicant's related company or licensee the mark in commerce on or in connection with the identified goods and/or services as of the filing date of the application. (15 U.S.C. Section 1051(b)).

Applicant hereby adds the following class of goods/services to the application:

New:

Class 003 for Scented oils used to produce aromas when heated; essential oils for household use

Section 1(b), the applicant has a bona fide intention to use or use through the applicant's related company or licensee the mark in commerce on or in connection with the identified goods and/or services as of the filing date of the application. (15 U.S.C. Section 1051(b)).

Fees

Fee(s) in the amount of \$325 is being submitted.

Declaration Signature

If the applicant is seeking registration under Section 1(b) and/or Section 44 of the Trademark Act, the applicant had a bona fide intention to use or use through the applicant's related company or licensee the mark in commerce on or in connection with the identified goods and/or services as of the filing date of the application. 37 C.F.R. Secs. 2.34(a)(2)(i); 2.34 (a)(3)(i); and 2.34(a)(4)(ii). If the applicant is seeking registration under Section 1(a) of the Trademark Act, the mark was in use in commerce on or in connection with the goods or services listed in the application as of the application filing date. 37 C.F.R. Secs. 2.34(a)(1)(i). The undersigned, being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. §1001, and that such willful false statements may jeopardize the validity of the application or any resulting registration, declares that he/she is properly authorized to execute this application on behalf of the applicant; he/she believes the applicant to be the owner of the trademark/service mark sought to be registered, or, if the application is being filed under 15 U.S.C. §1051(b), he/she believes applicant to be entitled to use such mark in commerce; to the best of his/her knowledge and belief no other person, firm, corporation, or association has the right to use the mark in commerce, either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion, or to cause mistake, or to deceive; that if the original application was submitted unsigned, that all statements in the original application and this submission made of the declaration signer's knowledge are true; and all statements in the original application and this submission made on information and belief are believed to be true.

Signature: /clark a. puntigam/ Date: 05/01/2007

Signatory's Name: Clark A. Puntigam

Signatory's Position: Attorney of Record

Response Signature

Signature: /clark a. puntigam/ Date: 05/01/2007

Signatory's Name: Clark A. Puntigam

Signatory's Position: Attorney of Record

The signatory has confirmed that he/she is an attorney who is a member in good standing of the bar of the highest court of a U.S. state, which includes the District of Columbia, Puerto Rico, and other federal territories and possessions; and he/she is currently the applicant's attorney or an associate thereof; and to the best of his/her knowledge, if prior to his/her appointment another U.S. attorney or a

Canadian attorney/agent not currently associated with his/her company/firm previously represented the applicant in this matter: (1) the applicant has filed or is concurrently filing a signed revocation of or substitute power of attorney with the USPTO; (2) the USPTO has granted the request of the prior representative to withdraw; (3) the applicant has filed a power of attorney appointing him/her in this matter; or (4) the applicant's appointed U.S. attorney or Canadian attorney/agent has filed a power of attorney appointing him/her as an associate attorney in this matter.

RAM Sale Number: 99

RAM Accounting Date: 05/02/2007

Serial Number: 77071961

Internet Transmission Date: Tue May 01 15:21:41 EDT 2007

TEAS Stamp: USPTO/ROA-64.221.36.243-2007050115214141

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EXHIBIT 10

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La Senza Corporation

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Fax: (514) 684-0258

<http://www.lasenza.com>

Statistics:

Public Company

Incorporated: 1982 as Suzy Shier Inc.

Employees: 6,063

Sales: \$189.1 million (2003)

Stock Exchanges: Toronto

Ticker Symbol: LSZ

NAIC: 448120 Women's Clothing Stores

Company Perspectives:

La Senza offers women and men a unique shopping experience with outstanding lingerie presentation in a beautiful and intimate environment, featuring everything from bras & panties, to sleepwear, loungewear, bodycare, accessories, and men's underwear.

Key Dates:

1968: Suzy Shier Inc. is launched.

1975: Dylex Ltd. acquires a controlling share of Suzy Shier.

1984: Wet Seal is acquired.

1990: La Senza lingerie division is formed, and the company's first stores opens.

1993: Suzy Shier is spun off as a public company.

2001: Suzy Shier changes its name to La Senza Corporation.

2003: La Senza opens its first U.S. store.

Company History:

La Senza Corporation is a major Canadian retailer of women's lingerie and apparel, avoiding the sexy niche carved out by Victoria's Secret and Fredericks of Hollywood in favor of focusing on high quality merchandise sold at affordable prices. Based near Montreal, the company owns and operates more than 200 La Senza Lingerie stores in Canada, and another 140 stores located in 18 countries, which includes licensed operations in the United Kingdom, the Middle East, and elsewhere. In addition, the company owns and operates more than 80 La Senza Girl stores, which target girls between 8 and 14 years of age. Through subsidiary Wet Seal, the company has operated in the United States since 1984, but only since 2003 has it attempt to crack the U.S. market with La Senza Lingerie. Although a public company, La Senza is 90 percent owned by chairman and CEO Irving Teitelbaum.

Suzy Shier: Mid-1960s to Mid-1980s

Teitelbaum, La Senza's cofounder, was born to Polish immigrants who came to Canada after World War I. He went to college at McGill University, then transferred to Sir George Williams College, where in June 1960 he graduated with a bachelor of commerce degree. Shortly thereafter he married and began his retail career, going to work for his father-in-law, Irwin Shier, who owned a junior department store in the Quebec area. Over the next several years he gained a practical education in the importance of catering to customers. He told *Canadian Business* in 2002 that working for a small town department store was an excellent training ground because "You're not making new customers every day, so you have to treat each person who comes into your store like a king or queen." In 1966, Shier was looking to open another department store when he came upon a mall in a desirable location, Sherbrooke, Quebec, but it only had a woman's wear shop available to lease. Aware that junior fashion was becoming very popular, he decided to lease the space and open a store, which would be named Suzy Shier, and offer trendy, yet moderately priced, apparel to the junior market. By this time, he had another son-in-law, Stephen Gross, who teamed with Teitelbaum to open the first Suzy Shier store in 1966. After Shier died in 1968, Teitelbaum and Gross began to aggressively expand the Suzy Shier concept.

Over the course of the next decade Suzy Shier grew into a 22-store chain with units spread across Canada, generating sales of \$7 million Canadian in 1975. At this point, the brothers-in-law needed more capital for expansion and in September 1975 they sold a 50.1 percent interest in Suzy Shier to Dylex Ltd., a Toronto-based holding company with a number of retail chains in its portfolio. Teitelbaum and Gross remained in charge of Suzy Shier, with Teitelbaum assuming the lead management role. Over the next ten years, with Dylex's backing, the chain was able to add another 50 units, with shops located in every major Canadian city as well as other smaller locales, such as Timmins, Sudbury, Sault Saint Marie, and Thunder Bay.

Wet Seal Acquired in 1984

During this period, Teitelbaum and Gross became interested in the U.S. market and took notice of a 16-store, Irvine, California-based chain, The Wet Seal Inc., which sold contemporary fashion apparel and accessories to juniors. Convinced that Wet Seal, despite losing money, was a good complement to Suzy Shier, they acquired an 80 percent interest in 1984 (half of which was owned by Dylex), made it profitable, and steadily expanded the chain in the United States. A key executive credited with the growth of Wet Seal was Kathy Bronstein, who in 1985 joined the subsidiary as the head of the merchandise group. She brought with her a good deal of experience in the junior market place. After earning an advertising degree from the University of Florida, she became an assistant buyer for a Philadelphia, Pennsylvania, chain called Deb Shops, then became the buyer for junior sportswear at Jordan Marsh. She relocated to southern California in 1979 to become a buyer for Fashion Conspiracy, followed by a stint with the Wild West chain before coming to Wet Seal. By 1992, she became the company's chief executive officer. In the meantime, in 1990, Wet Seal was spun off as a public company, raising \$41 million. Of that amount, \$20 million was used to repay loans from Dylex, which now needed the money because of recent losses as well as a heavy debt load. The remaining \$21 million would be used by Wet Seal to fuel further expansion. Over the next dozen years, Wet Seal grew to include some 600 stores divided among three chains. While Wet Seal continued to serve the youth market, Arden B stores catered to women and Zutopia targeted "tweens," girls between the ages of 8 and 14.

In the early 1980s, Teitelbaum and Gross launched another chain of apparel shops to cater to the junior market called L.A. Express, but by the end of the decade they sensed that both Suzy Shier and L.A. Express had peaked in Canada, and they looked for a new growth vehicle. At the time, lingerie retailer Victoria's Secret was making a splash in the United States, and the partners decided to try something similar in Canada, while avoiding the overtly sexual nature of Victoria's Secret. Suzy Shier was already carrying a modest line of undergarments and sleepwear, but because shelf space was limited and fearing that the traditional Suzy Shier customer might be confused by the sudden influx of lingerie, Teitelbaum and Gross elected to form a separate chain of lingerie shops under a new subsidiary. After toying with the Suzy's Secret as a name for the business, Teitelbaum drew on the Italian word for "without," *Senza*. He added the article "la" to feminize the name, creating "La Senza," which he felt "had a nice, luxurious ring to it." The basic business plan was to sell private-label lingerie--designed by the company with manufacturing outsourced--in a boutique format. The first La Senza shop opened in 1990 in Ottawa's Place D'Orleans Shopping Centre.

Placed in charge of the brand as president was British-born Laurence Lewin, who did not start out in the apparel industry. Rather he was an accountant by training who was working for Honeywell Information systems when he was sent to Montreal in the early 1970s to work on a project for Air Canada. In the mid-1970s, he accepted a chance to run a clothing chain, found that he loved the industry, and elected to make a career in apparel. Teitelbaum recruited him in 1987, initially hiring Lewin to serve as vice-president in charge of merchandising at Suzy Shier, but with the intention of eventually offering greater responsibility. With Lewin as president, La Senza grew quickly, so that by the end of 1992 the chain had grown to about 35 units.

As had been the case with Wet Seal, Suszy Shier's La Senza division needed more financial backing to support its growth than its corporate parent could provide. Because it was still strapped for cash, Dylex once again opted to make a public offering, spinning off Suzy Shier, which was one of its few consistent successes. In 1993, Dylex sold its entire 50.1 percent stake to underwriters, realizing approximately CAD \$60 million, while Suzy Shier also made shares available, raising about CAD \$18 million, which was used to double the size of the La Senza chain by the end of the year.

Over the next few years, Suzy Shier attempted to grow on a number of fronts. Looking to becoming international, the company targeted England, a large and fragmented market. It formed a company, La Senza plc, and in the final weeks of 1994 opened six La Senza stores in the United Kingdom. By early 1996, another 16 shops had opened and La Senza plc floated an offering on the Alternative Investment Market, garnering a great deal of attention by bringing pictures of lingerie-clad models to London's financial newspapers. In the United States, Wet Seal posted back-to-back unprofitable years, but because of aggressive cost-cutting measures, the unit was much better positioned than rivals who were not as quick to react to a downturn in the economy and lapsed into bankruptcy. In April 1995, Wet Seal was able to acquire the 237-store Contempo Casuals chain from Neiman Marcus, nearly tripling the size of Wet Seal, which operated 130 stores. A few weeks later, Suzy Shier, which had remained profitable despite difficult economic conditions, paid \$12 million to acquire a controlling interest in Wet Seal from

Dylex, which had just emerged from bankruptcy. A year later, in October 1996, Suzy Shier paid nearly CAD \$5.2 million to acquire the 42-store Silk & Satin lingerie chain from Woolworth Canada Inc. By this stage, Suzy Shier was operating 257 stores under the Suzy Shier and L.A. Express names and 145 La Senza stores.

Even while La Senza was making plans to open stores in additional countries, such as Saudi Arabia, the U.K. venture was beset with mounting losses, primarily because it attempted to grow too quickly and property rentals spiraled out of control. In September 1997, the company announced that the projections used in its listing prospectus "should be disregarded." By early 1998, however, the subsidiary was on the ropes and with no help forthcoming from the parent company, bankers were reluctant to step in to help out. As a result, the U.K. operation was sold for a token pound to a company owned by businessman Theo Paphitis, who owned Contessa Ladieswear among other assets. Going forward, Suzy Shier's La Senza shops in the U.K. would be run on a licensing basis.

Suzy Shier Adopts La Senza Name in 2001

Another venture that did not succeed for Suzy Shier was an attempt to open stores to serve women five-feet, four-inches and under in height. In general, it was the La Senza brand that was generating growth for the company. A new concept, La Senza Girl, aimed at 7- to 14-year-old girls, was quick to succeed and establish itself. The parent company, as a result, began to convert a significant number of L.A. Express and Suzy Shier stores to La Senza Girl outlets. In July 2001, Suzy Shier Limited became La Senza Corporation, a name which management believed was more in keeping with the direction the company was taking.

Not only was the Suzy Shier chain not doing as well as it had in the past, Wet Seal also endured a difficult stretch in 2002, which led to the dismissal of Bronstein as CEO. Teitelbaum replaced her on an interim basis. Effective June 30, 2003, a permanent CEO was hired, Peter D. Whitford, the former worldwide president of Disney Stores. In the meantime, the 178-unit Suzy Shier chain was put on the block. A buyer was found in YM Inc., which operated similar junior clothing stores, such as Stitches, Sirens, and Urban Planet. Hindering the transaction, however, was a probe launched by Canada's federal competition bureau, which charged that Suzy Shier had used misleading "regular" prices in order to convince consumers they were getting a better bargain. La Senza's management agreed to a CAD \$1 million fine but did not admit guilt. Teitelbaum told the *Toronto Star* that the company felt the matter was holding up the sale of the chain, adding, "It was obvious there was no way YM or anyone else was going to buy a Canadian retailer that had an ongoing investigation with the bureau hanging over its head." Just hours after the settlement was announced, the sale to YM was finalized. The terms of the agreement were not made public, but press accounts estimate the purchase price at CAD \$8 million.

In the same month that Suzy Shier was sold, La Senza opened its first outlet in the United States in a Rockaway, New Jersey, shopping center. Establishing a presence was imperative in achieving the goal of building La Senza into a true international brand. Within the year, a store opened in Garden City, New York, as well as three more units in Massachusetts. Management was confident that it would achieve success in the United States. It had some 20 years of operational experience in the country through Wet Seal, an advantage not enjoyed by many Canadian retailers who failed to crack the market. La Senza was also debt free and held cash investments. With 2,400 regional malls in the United States, half of which management considered suitable for housing a La Senza outlets, the lingerie chain appeared well positioned to realize a goal of one day operating 500 stores in the U.S. market.

Principal Competitors: Frederick's of Hollywood, Inc.; Movie Star, Inc.; Victoria's Secret Stores, Inc.

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Further Reading:

- Aarsteinsen, Barbara, "Suzy Shier Expanding with New Lingerie Claim," *Toronto Star*, December 11, 1990, p. F1.
- Bitti, Mary Teresa, "Speaking of Unmentionables: Man of La Senza," *Financial Post*, February 1, 1994, p. 28.
- Cohen, Elaine, "La Senza a Leader in Canada's Lingerie Market," *Canadian Jewish News*, January 15, 1998.
- Heinzl, John, "Dylex to Take Women's Wear, Lingerie Unit Public," *Globe and Mail*, April 15, 1993.
- Olijnyk, Zena, "Va va va Boom," *Canadian Business*, May 13, 2002, p. 48.

Source: *International Directory of Company Histories*, Vol. 66. St. James Press, 2004.

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Word Mark LA SENZA LINGERIE

Translations The word "LA" may be translated to mean "THE", and the word "SENZA" may be translated from Italian to English to mean "WITHOUT".

Goods and Services (ABANDONED) IC 003. US 001 004 006 050 051 052. G & S: (Based on 44(e)) (based upon Canadian Registration 499163) sachets, cosmetics, namely, body creams; soaps; body powders and lotions; (Based on Intent to Use) potpourri; bubble bath and massage oils

(ABANDONED) IC 025. US 022 039. G & S: (Based on 44(e)) (based upon Canadian Registration 499163) ladies' t-shirts, vests, robes, bathrobes; loungewear, namely, dressy pajamas, one-piece and two-piece jumpsuits, leggings with matching tops as well as bottoms with matching blouses or tops; pajamas, night gowns, camisoles, panties, brassieres, slips, teddies, garter belts, garters, nylons, pantyhose, slippers; (Based on Intent to Use) swimsuits and matching coverups; two-piece sets consisting of camisoles and panties, boxers or slips, tank tops; sleepshirts; bustiers; crop tops; drawstring pants; baseball caps; and kimonos

Mark Drawing Code (3) DESIGN PLUS WORDS, LETTERS, AND/OR NUMBERS

Design Search Code 09.03.25 - Bath robes; Costumes (Halloween or masquerade); Jump suits; Kimonos; Leotards; Robes; Surgical gowns; Suspenders (clothing); Uniforms; Vestments
10.03.01 - Fans, hand-held
26.15.21 - Polygons that are completely or partially shaded

Serial Number 76172127

Filing Date November 28, 2000

Current Filing Basis 1B;44E

Original Filing Basis 1B;44E

Published for Opposition December 3, 2002

Owner (APPLICANT) La Senza Inc. CORPORATION CANADA 1370 Dundas Street East, Suite 210 Mississauga, Ontario CANADA L4Y 4G4

Attorney of Record SIMOR L. MOSKOWITZ
Prior Registrations 1800379;1994349
Disclaimer NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "LINGERIE" APART FROM THE MARK AS SHOWN
Type of Mark TRADEMARK
Register PRINCIPAL
Live/Dead Indicator DEAD
Abandonment Date August 26, 2003

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Serial Number: 76172127 Assignment Information Trademark Document Retrieval

Registration Number: (NOT AVAILABLE)

Mark



(words only): LA SENZA LINGERIE

Standard Character claim: No

Current Status: Abandoned: No Statement of Use filed after Notice of Allowance was issued.

Date of Status: 2003-08-26

Filing Date: 2000-11-28

Transformed into a National Application: No

Registration Date: (DATE NOT AVAILABLE)

Register: Principal

Law Office Assigned: LAW OFFICE 109

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Current Location: 900 -File Repository (Franconia)

Date In Location: 2004-03-11

LAST APPLICANT(S)/OWNER(S) OF RECORD

1. La Senza Inc.

Address:

La Senza Inc.

1370 Dundas Street East, Suite 210

Mississauga, Ontario L4Y 4G4

Canada

Legal Entity Type: Corporation

State or Country of Incorporation: Canada

GOODS AND/OR SERVICES

International Class: 003

Class Status: Active

(Based on 44(e)) (based upon Canadian Registration 499163) sachets, cosmetics, namely, body creams; soaps; body powders and lotions; (Based on Intent to Use) potpourri; bubble bath and massage oils

Basis: 1(b), 44(e)

First Use Date: (DATE NOT AVAILABLE)

First Use in Commerce Date: (DATE NOT AVAILABLE)

International Class: 025

Class Status: Active

(Based on 44(e)) (based upon Canadian Registration 499163) ladies' t-shirts, vests, robes, bathrobes; loungewear, namely, dressy pajamas, one-piece and two-piece jumpsuits, leggings with matching tops as well as bottoms with matching blouses or tops; pajamas, night gowns, camisoles, panties, brassieres, slips, teddies, garter belts, garters, nylons, pantyhose, slippers; (Based on Intent to Use) swimsuits and matching coverups; two-piece sets consisting of camisoles and panties, boxers or slips, tank tops; sleepshirts; bustiers; crop tops; drawstring pants; baseball caps; and kimonos

Basis: 1(b), 44(e)

First Use Date: (DATE NOT AVAILABLE)

First Use in Commerce Date: (DATE NOT AVAILABLE)

ADDITIONAL INFORMATION

Disclaimer: "LINGERIE"

Translation: The word "LA" may be translated to mean "THE", and the word "SENZA" may be translated from Italian to English to mean "WITHOUT".

Design Search Code(s):

09.03.25 - Bath robes; Costumes (Halloween or masquerade); Jump suits; Kimonos; Leotards; Robes; Surgical gowns; Suspenders (clothing); Uniforms; Vestments

10.03.01 - Fans, hand-held

26.15.21 - Polygons that are completely or partially shaded

Prior Registration Number(s):

1800379

1994349

Foreign Registration Number: 499163

Foreign Registration Date: 1998-08-25

Country: Canada

Foreign Expiration Date: 2013-08-25

MADRID PROTOCOL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

NOTE: To view any document referenced below, click on the link to "Trademark Document Retrieval" shown near the top of this page.

2004-03-10 - Abandonment - No use statement filed

2003-02-25 - Noa Mailed - SOU Required From Applicant

2002-12-03 - Published for opposition

2002-11-13 - Notice of publication

2002-08-20 - Approved for Pub - Principal Register (Initial exam)

2002-07-19 - Communication received from applicant

2002-07-19 - PAPER RECEIVED

2002-03-18 - Final refusal mailed

2001-10-31 - Communication received from applicant

2001-06-01 - Non-final action mailed

2001-05-29 - Assigned To Examiner

ATTORNEY/CORRESPONDENT INFORMATION

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Typed Drawing

Word Mark

LA SENZA AQUA

Goods and Services

(ABANDONED) IC 003. US 001 004 006 050 051 052. G & S: Eau de parfum, eau de cologne, eau de toilette, skin moisturizers, namely, body mist and body splash, shower and bath gel, skin lotion, body cream, bubble bath, bath fizzlers, exfoliating skin lotion, skin soap, massage oil, scented bath beads, body oil, skin mousse, scented sachets, and gift sets comprising one or more of the foregoing goods

(ABANDONED) IC 004. US 001 006 015. G & S: scented candles

(ABANDONED) IC 009. US 021 023 026 036 038. G & S: music CD's

(ABANDONED) IC 014. US 002 027 028 050. G & S: watches

(ABANDONED) IC 016. US 002 005 022 023 029 037 038 050. G & S: stationery products, namely, agendas, notebooks and pens

(ABANDONED) IC 018. US 001 002 003 022 041. G & S: umbrellas, lipstick cases, cosmetic bags sold empty and promotional bags

(ABANDONED) IC 020. US 002 013 022 025 032 050. G & S: handheld compact mirrors

(ABANDONED) IC 021. US 002 013 023 029 030 033 040 050. G & S: exfoliating pads and exfoliating mitts

(ABANDONED) IC 025. US 022 039. G & S: t-shirts and sleepshirts

(ABANDONED) IC 028. US 022 023 038 050. G & S: Toy watches and Christmas tree ornaments

(1) TYPED DRAWING

Mark Drawing Code

Serial Number 76173653

Filing Date November 30, 2000

Current Filing Basis 1B;44D

Original Filing Basis 1B;44D

Owner (APPLICANT) La Senza Inc CORPORATION CANADA 1370 Dundas Street East Suite 210 Mississauga, Ontario

CANADA L4Y 4G4

Attorney of Record SIMOR L MOSKOWITZ

Priority Date August 7, 2000

Prior Registrations 1800379;1994349

Type of Mark TRADEMARK

Register PRINCIPAL

Live/Dead Indicator DEAD

Abandonment Date August 8, 2002

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Serial Number: 76173653 Assignment Information Trademark Document Retrieval

Registration Number: (NOT AVAILABLE)

Mark (words only): LA SENZA AQUA

Standard Character claim: No

Current Status: Abandoned: Applicant's express request.

Date of Status: 2002-09-12

Filing Date: 2000-11-30

Transformed into a National Application: No

Registration Date: (DATE NOT AVAILABLE)

Register: Principal

Law Office Assigned: LAW OFFICE 104

If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at TrademarkAssistanceCenter@uspto.gov

Current Location: 900 -File Repository (Franconia)

Date In Location: 2002-09-20

LAST APPLICANT(S)/OWNER(S) OF RECORD

1. La Senza Inc

Address:

La Senza Inc
1370 Dundas Street East Suite 210
Mississauga, Ontario L4Y 4G4
Canada

Legal Entity Type: Corporation

State or Country of Incorporation: Canada

GOODS AND/OR SERVICES

International Class: 003**Class Status:** Active

Eau de parfum, eau de cologne, eau de toilette, skin moisturizers, namely, body mist and body splash, shower and bath gel, skin lotion, body cream, bubble bath, bath fizzlers, exfoliating skin lotion, skin soap, massage oil, scented bath beads, body oil, skin mousse, scented sachets, and gift sets comprising one or more of the foregoing goods

Basis: 1(b), 44(d)**First Use Date:** (DATE NOT AVAILABLE)**First Use in Commerce Date:** (DATE NOT AVAILABLE)**International Class: 004****Class Status:** Inactive - Insufficient Fee Received

scented candles

Basis: 1(b), 44(d)**First Use Date:** (DATE NOT AVAILABLE)**First Use in Commerce Date:** (DATE NOT AVAILABLE)**International Class: 009****Class Status:** Inactive - Insufficient Fee Received

music CD's

Basis: 1(b), 44(d)**First Use Date:** (DATE NOT AVAILABLE)**First Use in Commerce Date:** (DATE NOT AVAILABLE)**International Class: 014****Class Status:** Inactive - Insufficient Fee Received

watches

Basis: 1(b), 44(d)**First Use Date:** (DATE NOT AVAILABLE)**First Use in Commerce Date:** (DATE NOT AVAILABLE)**International Class: 016****Class Status:** Inactive - Insufficient Fee Received

stationery products, namely, agendas, notebooks and pens

Basis: 1(b), 44(d)**First Use Date:** (DATE NOT AVAILABLE)**First Use in Commerce Date:** (DATE NOT AVAILABLE)**International Class: 018****Class Status:** Inactive - Insufficient Fee Received

umbrellas, lipstick cases, cosmetic bags sold empty and promotional bags

Basis: 1(b), 44(d)**First Use Date:** (DATE NOT AVAILABLE)**First Use in Commerce Date:** (DATE NOT AVAILABLE)**International Class: 020****Class Status:** Inactive - Insufficient Fee Received

handheld compact mirrors

Basis: 1(b), 44(d)**First Use Date:** (DATE NOT AVAILABLE)**First Use in Commerce Date:** (DATE NOT AVAILABLE)**International Class: 021****Class Status:** Inactive - Insufficient Fee Received

exfoliating pads and exfoliating mitts

Basis: 1(b), 44(d)

First Use Date: (DATE NOT AVAILABLE)

First Use in Commerce Date: (DATE NOT AVAILABLE)

International Class: 025

Class Status: Inactive - Insufficient Fee Received

t-shirts and sleepshirts

Basis: 1(b), 44(d)

First Use Date: (DATE NOT AVAILABLE)

First Use in Commerce Date: (DATE NOT AVAILABLE)

International Class: 028

Class Status: Inactive - Insufficient Fee Received

Toy watches and Christmas tree ornaments

Basis: 1(b), 44(d)

First Use Date: (DATE NOT AVAILABLE)

First Use in Commerce Date: (DATE NOT AVAILABLE)

ADDITIONAL INFORMATION

Prior Registration Number(s):

1800379

1994349

Foreign Application Number: 1,069,973

Country: Canada

Foreign Filing Date: 2000-08-07

MADRID PROTOCOL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

NOTE: To view any document referenced below, click on the link to "Trademark Document Retrieval" shown near the top of this page.

2002-09-12 - Abandonment - Express mailed

2002-08-08 - Communication received from applicant

2002-08-08 - PAPER RECEIVED

2002-08-06 - Letter of suspension mailed

2002-07-09 - Communication received from applicant

2002-07-09 - PAPER RECEIVED

2002-01-09 - Letter of suspension mailed

2001-10-23 - Communication received from applicant

2001-04-23 - Non-final action mailed

2001-03-27 - Assigned To Examiner

ATTORNEY/CORRESPONDENT INFORMATION

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Correspondent

SIMOR L MOSKOWITZ

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Typed Drawing

Word Mark	LA SENZA SPA
Translations	The wording "LA SENZA" can be translated into English as "THE WITHOUT."
Goods and Services	(ABANDONED) IC 003. US 001 004 006 050 051 052. G & S: BODY CREAMS, LOTIONS, OILS, COSMETICS; HAIR PRODUCTS, NAMELY SHAMPOO AND HAIR RINSES; BODY AND FACIAL MASKS; SOAP; PERFUMES AND COLOGNES
	(ABANDONED) IC 044. US 100 101. G & S: MANICURE, PEDICURE, FACIAL, MASSAGE, EXFOLIATION, WAXING, AROMATHERAPY TREATMENTS, BEAUTY TREATMENTS, HAIRCUTS AND STYLING
Mark Drawing Code	(1) TYPED DRAWING
Serial Number	76542041
Filing Date	September 2, 2003
Current Filing Basis	1B;44D
Original Filing Basis	1B;44D
Owner	(APPLICANT) LA SENZA, INC. CORPORATION CANADA 1370 DUNDAS STREET EAST, STE. 210 MISSISSAUGA, ONTARIO CANADA L4Y 4G4
Assignment Recorded	ASSIGNMENT RECORDED
Attorney of Record	GEORGE W. LEWIS
Priority Date	August 13, 2003
Prior Registrations	1800379;1994349;2606910;2614315
Disclaimer	NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "SPA" APART FROM THE MARK AS SHOWN
Type of Mark	TRADEMARK. SERVICE MARK
Register	PRINCIPAL
Live/Dead Indicator	DEAD
Abandonment Date	September 19, 2005

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Serial Number: 76542041 Assignment Information Trademark Document Retrieval

Registration Number: (NOT AVAILABLE)

Mark (words only): LA SENZA SPA

Standard Character claim: No

Current Status: Abandoned-Failure To Respond Or Late Response

Date of Status: 2005-10-29

Filing Date: 2003-09-02

Transformed into a National Application: No

Registration Date: (DATE NOT AVAILABLE)

Register: Principal

Law Office Assigned: LAW OFFICE 111

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Current Location: M2X -TMO Law Office 111 - Examining Attorney Assigned

Date In Location: 2005-10-29

LAST APPLICANT(S)/OWNER(S) OF RECORD

1. LA SENZA, INC.

Address:

LA SENZA, INC.
1370 DUNDAS STREET EAST, STE. 210
MISSISSAUGA, ONTARIO L4Y 4G4
Canada

Legal Entity Type: Corporation

State or Country of Incorporation: Canada

GOODS AND/OR SERVICES

International Class: 003

Class Status: Active

BODY CREAMS, LOTIONS, OILS, COSMETICS; HAIR PRODUCTS, NAMELY SHAMPOO AND HAIR RINSES; BODY AND FACIAL MASKS; SOAP; PERFUMES AND COLOGNES

Basis: 1(b), 44(d)

First Use Date: (DATE NOT AVAILABLE)

First Use in Commerce Date: (DATE NOT AVAILABLE)

International Class: 044

Class Status: Active

MANICURE, PEDICURE, FACIAL, MASSAGE, EXFOLIATION, WAXING, AROMATHERAPY TREATMENTS, BEAUTY TREATMENTS, HAIRCUTS AND STYLING

Basis: 1(b), 44(d)

First Use Date: (DATE NOT AVAILABLE)

First Use in Commerce Date: (DATE NOT AVAILABLE)

ADDITIONAL INFORMATION

Disclaimer: "SPA"

Translation: The wording "LA SENZA" can be translated into English as "THE WITHOUT."

Prior Registration Number(s):

1800379

1994349

2606910

2614315

Country: Canada

Foreign Filing Date: 2003-08-13

MADRID PROTOCOL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

NOTE: To view any document referenced below, click on the link to "Trademark Document Retrieval" shown near the top of this page.

2005-10-31 - Abandonment Notice Mailed - Failure To Respond

2005-10-29 - Abandonment - Failure To Respond Or Late Response

2005-03-17 - Inquiry as to suspension mailed

2005-03-16 - Suspension Inquiry Written

2004-11-26 - LIE Checked Susp - To Atty For Action

2004-04-21 - Letter of suspension mailed
2004-03-24 - Communication received from applicant
2004-03-24 - PAPER RECEIVED
2003-09-30 - Non-final action mailed
2003-09-29 - Assigned To Examiner

ATTORNEY/CORRESPONDENT INFORMATION

Attorney of Record

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GEORGE W. LEWIS
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THE JENIFER BUILDING
400 SEVENTH STREET, N.W.
WASHINGTON, D.C. 20004-2201
Phone Number: (202) 638-6666
Fax Number: (202) 393-5350/51/52

Domestic Representative

JACOBSON HOLMAN PLLC
Phone Number: (202) 638-6666
Fax Number: (202) 393-5350/51/52

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LOVE LA SENZA

Word Mark LOVE LA SENZA

Goods and Services IC 004. US 001 006 015. G & S: BRAZILIAN, CANDLES, CHEMISES, CHOKERS, FEATHER JACKETS, FISHNET STOCKINGS, LOVE CUFFS, OPERA MASKS, MIRRORS, NIPPLE TASSELS, PATENT LEATHER ARM BANDS, SATIN HANDBAGS, SATIN TIES, SKIRTS, STAY UP STOCKINGS, STOCKINGS WITH A SATIN BOW, WAIST CINCHES AND A WEEKEND KIT CONTAINING WARMING MASSAGE OIL, BODY BALM, BODY CANDY PACKET, TEA LIGHTS, SATIN EYE MASK AND A GAME BOARD, MERRYWIDOWS, SLIPPERS, SCARVES AND HANDBAGS

Standard Characters Claimed

Mark Drawing Code (4) STANDARD CHARACTER MARK

Serial Number 77648660

Filing Date January 13, 2009

Current Filing Basis 1B;44D;44E

Original Filing Basis 1B;44D;44E

Owner (APPLICANT) La Senza Corporation CORPORATION CANADA 1608 St. Regis Blvd. Dorval, Quebec CANADA H9P1H6

Attorney of Record GEORGE W. LEWIS

Priority Date July 17, 2008

Type of Mark TRADEMARK

Register PRINCIPAL

Live/Dead Indicator LIVE

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Serial Number: 77648660 Assignment Information Trademark Document Retrieval

Registration Number: (NOT AVAILABLE)

Mark

LOVE LA SENZA

(words only): LOVE LA SENZA

Standard Character claim: Yes

Current Status: A non-final action has been mailed. This is a letter from the examining attorney requesting additional information and/or making an initial refusal. However, no final determination as to the registrability of the mark has been made.

Date of Status: 2009-04-01

Filing Date: 2009-01-13

Transformed into a National Application: No

Registration Date: (DATE NOT AVAILABLE)

Register: Principal

Law Office Assigned: LAW OFFICE 101

Attorney Assigned:
GOODSAID IRA J

Current Location: L1X -TMEG Law Office 101 - Examining Attorney Assigned

Date In Location: 2009-04-01

LAST APPLICANT(S)/OWNER(S) OF RECORD

1. La Senza Corporation

Address:
La Senza Corporation

1608 St. Regis Blvd.
Dorval, Quebec H9P1H6
Canada

Legal Entity Type: Corporation

State or Country of Incorporation: Canada

GOODS AND/OR SERVICES

International Class: 004

Class Status: Active

BRAZILIAN, CANDLES, CHEMISES, CHOKERS, FEATHER JACKETS, FISHNET STOCKINGS, LOVE CUFFS, OPERA MASKS, MIRRORS, NIPPLE TASSELS, PATENT LEATHER ARM BANDS, SATIN HANDBAGS, SATIN TIES, SKIRTS, STAY UP STOCKINGS, STOCKINGS WITH A SATIN BOW, WAIST CINCHES AND A WEEKEND KIT CONTAINING WARMING MASSAGE OIL, BODY BALM, BODY CANDY PACKET, TEA LIGHTS, SATIN EYE MASK AND A GAME BOARD, MERRYWIDOWS, SLIPPERS, SCARVES AND HANDBAGS

Basis: 1(b), 44(d), 44(e)

First Use Date: (DATE NOT AVAILABLE)

First Use in Commerce Date: (DATE NOT AVAILABLE)

ADDITIONAL INFORMATION

Foreign Application Number: 1,248,022-1

Country: Canada

Foreign Filing Date: 2008-07-17

Foreign Registration Number: TMA689,987

Foreign Registration Date: 2007-06-15

Country: Canada

Foreign Expiration Date: 2022-06-15

MADRID PROTOCOL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

NOTE: To view any document referenced below, click on the link to "Trademark Document Retrieval" shown near the top of this page.

2009-04-01 - Notification Of Non-Final Action E-Mailed

2009-04-01 - Non-final action e-mailed

2009-04-01 - Non-Final Action Written

2009-03-25 - Assigned To Examiner

2009-01-16 - New Application Entered In Tram

ATTORNEY/CORRESPONDENT INFORMATION

Attorney of Record

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Correspondent

GEORGE W. LEWIS
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Fax Number: 202-393-5350

Domestic Representative

GEORGE W. LEWIS
Phone Number: 202-638-6666
Fax Number: 202-393-5350

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REFINE YOUR SEARCH

BY CATEGORY:

Accessories (3)
Sale & Specials (2)

BY FABRIC:



Body Care (2)
Lotion (1)

1 - 3 of 3 Search Results for: **massage oil**

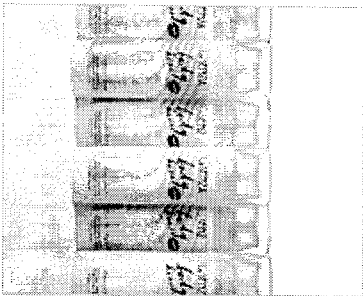
There were no products that contained **all** of the words you searched for. The below results contain **some** of the words.

Sort By:

Relevance

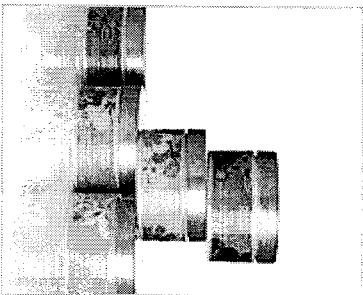
Grid  List 

Showing 1-3 of 3



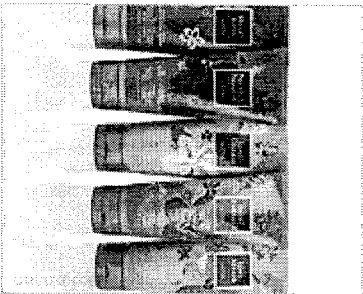
Indulgent Swirl Cream

Special 2/\$20.00



Super-Rich Body Butter

Special 5/\$25.00



Hand & Body Cream

Special 5/\$25.00

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S



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SEARCH

BRAS | **PANTIES** | **SEXY LINGERIE** | **SLEEP & LOUNGE** | **ACCESSORIES** | **LA SENZA SPIRIT** | **SALE & SPECIALS** | **COLLECTIONS**

REFINE YOUR SEARCH

BY CATEGORY:

Accessories (5)
Sale & Specials (4)
Sleep & Lounge (1)

BY FABRIC:

Body Care (2)
Fragrance (1)
Liquid (1)
Lotion (1)
Terry (1)

BY COLOR:

Beauty (2)
Pinks (1)
Yellows (1)

BY PRICE:

Under \$30 (5)
\$30 to \$40 (1)

1 - 6 of 6 Search Results for: **bath oil**

There were no products that contained **all** of the words you searched for. The below results contain **some** of the words.

Sort By:

Relevance

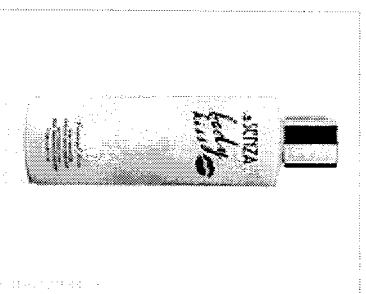
Grid List

Showing 1-6 of 6



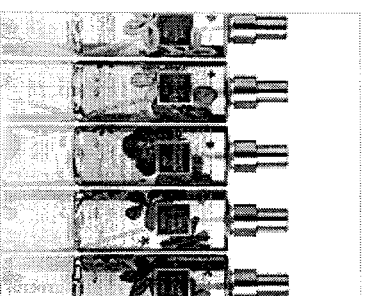
Luxurious Bath & Shower Gel

Special 5 / \$25.00



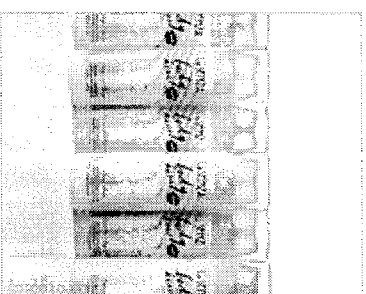
3-in-1 Wash for Shower, Bath and Hair

Special 2 / \$20.00



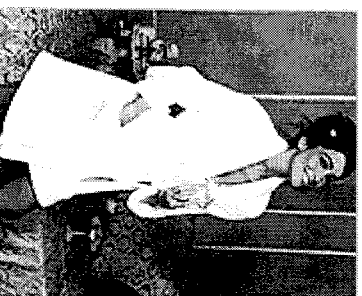
Fragrant Body Splash

Special 5 / \$25.00



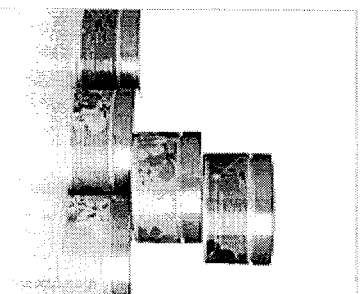
Indulgent Swift Cream

Special 2 / \$20.00



Short Micro-Terry Robe

\$39.50



Super-Rich Body Butter

Special 5 / \$25.00

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REFINE YOUR SEARCH

BY CATEGORY:

Accessories (2)
Sale & Specials (1)

BY FABRIC:

Body Care (1)
Lotion (1)

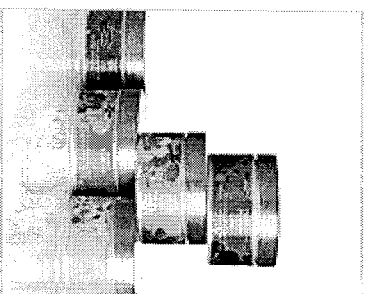
1 - 2 of 2 Search Results for: **body oil**

Sort By:

Relevance

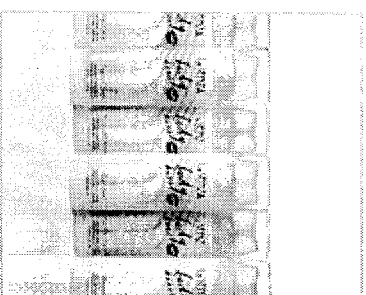
Grid ☐ List ☒

Showing 1-2 of 2



Super-Rich Body Butter

Special 5 / \$25.00



Indulgent Swirl Cream

Special 2 / \$20.00

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- |
- [SLEEP & LOUNGE](#)
- |
- [ACCESSORIES](#)
- |
- [LA SENZA SPIRIT](#)
- |
- [SALE & SPECIALS](#)
- |
- [COLLECTIONS](#)

REFINE YOUR SEARCH

BY CATEGORY:

Accessories (12)
Sale & Specials (5)

BY FABRIC:

Body Care (1)
Fragrance (3)
Liquid (3)
Lotion (3)

BY COLOR:

Beauty (6)
Whites (1)

1 - 12 of 12 Search Results for: scented candles

Sort By:

Relevance

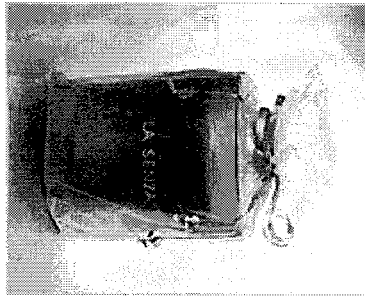
Grid ☐ List ☐

Showing 1-12 of 12



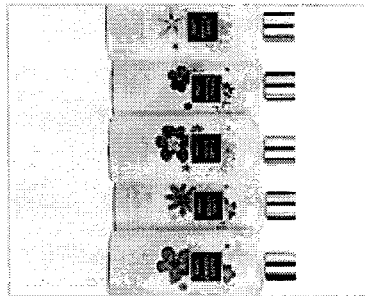
3-in-1 Wash for Shower, Bath and Hair

Special 2 / \$20.00



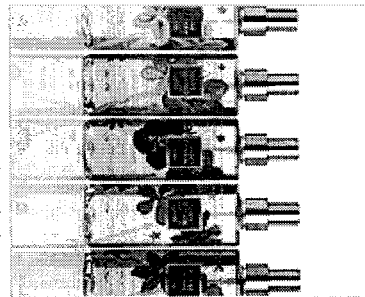
Glass Candle

\$14.50



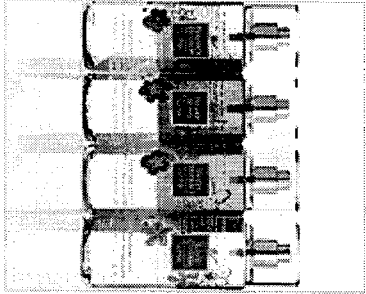
Nourishing Body Lotion

Special 5 / \$25.00



Fragrant Body Splash

Special 5 / \$25.00



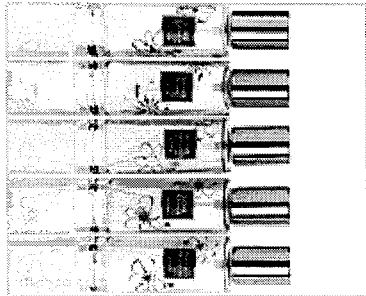
Moisture Mist

Special 5 / \$25.00



Luxurious Body Wash

Special 5 / \$25.00



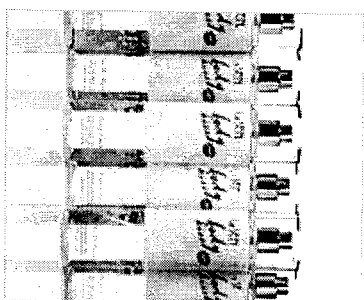
Eau de Toilette

Special 5 / \$25.00

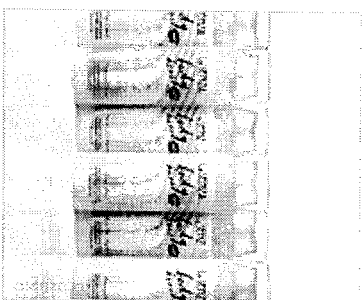


Shimmer Fragrance Mist

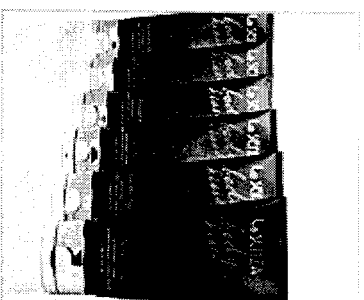
Special 2 / \$20.00



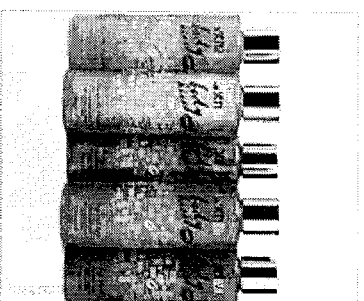
Moisture Double Mist
Special 2/\$20.00



Indulgent Swirl Cream
Special 2/\$20.00



Quench Body Lotion
Special 2/\$20.00



Lavish Body Wash
Special 2/\$20.00

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EXHIBIT 19

Hearing:
November 2, 1984

FOR PUBLICATION IN FULL

MGravette
Paper No.

U. S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Kastle Systems, Inc.

Serial Nos. 332,494 and 332,495

Donald A. Kaul for applicant.

L. Beresford, Trademark Examining Attorney, Law Office IV,
(T. Lamone, Managing Attorney) for the Patent and Trademark
Office.

Before Rice, Simms and Krugman, Members.

Opinion by Krugman, Member:

Applications have been filed by Kastle Systems, Inc.
to register "KASTLE"⁽¹⁾ and "KASTLE SYSTEMS"⁽²⁾ (the word
SYSTEMS being disclaimed apart from the mark) both for building
security services, namely, electronically controlling building
access from a remote location and transmitting an electric
signal to unlock the building and admit authorized personnel
thereto.

Registration has been refused in each instance under
Section 2(d) of the Act on the ground that the mark in each
application so resembles the previously registered marks

(1) Application Serial No. 332,494 filed October 15, 1981.

(2) Application Serial No. 332,495 filed October 15, 1981.

Serial No. 332,494
Serial No. 332,495

"CASTLE WATCHERS" for the services of guarding and care of homes during absence of occupants⁽³⁾ and "CASTLE" in the form depicted below for security devices, namely, padlocks, chains and cables⁽⁴⁾

Castle

as to be likely, when applied to applicant's services, to cause confusion, mistake or to deceive. Specifically, the Examining Attorney asserts that KASTLE is the phonetic equivalent of CASTLE and that the CASTLE portion of CASTLE WATCHERS is the dominant part of the mark since WATCHERS is highly suggestive of that registrant's services. The Examining Attorney maintains that applicant's services are closely related to the goods and services covered by the cited registrations since applicant and the registrants are engaged in providing different types of security.

Applicant has appealed,⁽⁵⁾ asserting that with respect to the cited mark CASTLE in special form, applicant's

(3) Registration No. 930,991 issued March 14, 1972. Section 8 affidavit accepted.

(4) Registration No. 1,154,518 issued May 19, 1981.

(5) In view of the similarity of issues presented by these two cases, the appeals were consolidated.

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Serial No. 332,495

mark KASTLE differs in appearance and meaning from the registered mark since KASTLE has no meaning while CASTLE means fortress or a place of privacy or refuge, and that the difference in appearance and meaning is underscored by the Gothic or "medieval" appearing lettering in the registered mark. Applicant argues that its other mark KASTLE SYSTEMS differs from CASTLE in the same way as applicant's KASTLE mark does as well as because of the additional word SYSTEMS. Moreover, applicant asserts that the combination of KASTLE and SYSTEMS in no way results in a term which means or is equivalent to a castle as that term is commonly understood.

With respect to the other cited mark, CASTLE WATCHERS, applicant argues that said mark is clearly different from either of applicant's marks in appearance, sound and meaning; and that CASTLE WATCHERS, as applied to the services of guarding and care of homes during the absence of occupants, is highly suggestive of the services and creates a commercial impression distinguishable from the commercial impressions engendered by applicant's two marks.

Applicant, in addition to arguing the differences in the respective marks, points out that the two cited registrations issued to two separate entities.

With respect to the respective goods and services, applicant notes that the goods covered by the CASTLE registration are security devices, namely, padlocks, chains and

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Serial No. 332,495

cables and that these goods are not electronic, nor are they devices which could be used as components in a sophisticated security system in a building. Similarly, applicant asserts that the services covered by the CASTLE WATCHERS registration, namely, guarding and care of homes during the absence of occupants, does not include anything remotely related to applicant's services of electronically controlling building access from a remote location and transmitting an electric signal to unlock the building and to admit authorized personnel thereto. Applicant concludes that its services, by their nature, are directed to owners and property managers of commercial buildings; that the nature of applicant's services requires prewiring of a building and a computerized control system at a remote location together with coded access codes, electronic controls for elevators and door locks and telephone systems to communicate with would be entrants who encounter difficulty in entering the building. Applicant contrasts these services with the conventional security devices covered by the CASTLE registration which are ordinarily sold to the general public over the counter in hardware or other retail stores. Applicant further points out that the services offered under the CASTLE WATCHERS mark are house-sitting services and are directed to homeowners. Applicant concludes, therefore, that when the relevant factors are weighed, it is clear that no source confusion is likely.

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Serial No. 332,495

In the present case, registration has been refused in each instance under Section 2(d) in view of two registrations issued to two different entities. In determining whether applicant's use of its mark in connection with its services would be likely to cause source confusion in view of the existence of either or both of the registered marks, we will discuss the Section 2(d) issue separately with respect to each of the cited registrations.

I. The "CASTLE WATCHERS" registration

This registered mark is for services identified as the guarding and care of homes during absence of occupants. These services appear to be in the nature of house-sitting services wherein the absent occupants of a home will contract to have their home periodically checked, mail taken in, plants watered and the like. However, while both applicant's services and those covered by the cited registration are concerned with security, this is too broad a category, in our view, to conclude that source confusion is likely when similar marks are used in connection with widely divergent aspects of the security field. It is clear from the nature of applicant's services that they are designed for multi-unit buildings, be they office buildings, high-rise apartment houses or condominiums. These services are necessarily directed not to the office workers or apartment dwellers that occupy these buildings but, rather, the building managers or owners who must

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Serial No. 332,495

determine whether the substantial expenditure necessary to obtain applicant's services is justified. It thus appears that the respective services are directed to different classes of purchasers. It is true that building managers or building owners may also be homeowners and, therefore, potential customers of registrant's services. Equally true is the possibility that the office workers and/or apartment or condominium dwellers who are beneficiaries of applicant's services and who receive an entry card with applicant's KASTLE or KASTLE SYSTEM mark appearing thereon might be potential customers of registrant's "CASTLE WATCHERS" service. However, we think that while there is some overlap in the group of people exposed to both applicant's marks and registrant's mark used in connection with the respective services, the nature of the respective services is so different that source confusion, while possible, is not likely. Buttressing this conclusion is our view that while applicant's marks and the mark in the cited registration have the same element "CASTLE" or its phonetic equivalent "KASTLE," the marks engender different commercial impressions. Registrant's mark suggests the nature of the services offered under the mark, that is, watching or looking after one's home (as in the expression "a man's home is his castle"). While applicant's KASTLE mark may engender the same impression as its phonetic equivalent CASTLE, it does not suggest the same concept of looking after or guarding one's

Serial No. 332,494
Serial No. 332,495

castle. With respect to applicant's KASTLE SYSTEMS mark, we think the impression made by this term is arbitrary since the appearance of "SYSTEMS" together with "KASTLE" tends to blur the common, ordinary meaning of the word castle.

In short, because of the vastly different services offered and taking into consideration the differences in the commercial impressions engendered by the marks used in connection with these services, we think that confusion as to source or origin is unlikely.

II. The "CASTLE" (in special form) registration

This registered mark is for security devices, namely, padlocks, chains and cables. With respect to this cited registration, we are of the view that applicant's marks are quite similar to registrant's mark, much more so than they are with respect to the previously discussed "CASTLE WATCHERS" mark. We do not find the lettering in registrant's "CASTLE" mark to be sufficiently eye-catching or unusual to significantly change the commercial impression created by the word "CASTLE." Since KASTLE is the phonetic equivalent of CASTLE, we find these two marks to be substantially identical. Moreover, we find "CASTLE" to be highly similar to "KASTLE SYSTEMS." However, notwithstanding the similarities in the marks, we nevertheless are constrained to find no likelihood of confusion from the contemporaneous use of the respective marks on the goods and services in view of the radical differences

Serial No. 332,494
Serial No. 332,495

between these goods and services. Again, as in the case with the "CASTLE WATCHERS" mark, both applicant and the owner of the "CASTLE" mark are involved in the broad field of security. Further, we agree that the building managers and building owners to whom applicant's services are directed and the occupants of buildings served by applicant, cognizant of applicant's services rendered under the marks, would be potential customers for padlocks and other security devices for their own homes. However, we think that the differences between registrant's padlocks and other conventional security devices sold through hardware stores and other such outlets common for goods of this type and applicant's sophisticated electronic building security services are so great that purchasers of registrant's security devices who might be familiar with applicant's security systems (or vice versa) would not be likely to ascribe a common origin to the goods and services, even when rendered under the same or similar marks. Decision: The refusal of registration is reversed in each case and both marks will be published for opposition.

J. E. Rice
J. E. Rice

R. L. Simms
R. L. Simms

G. D. Krugman
G. D. Krugman

Members, Trademark Trial
and Appeal Board

30 NOV 1984

APPEARANCE RECORD

HEARING DATE

11-02-84

TIME

1:30 p.m.

INSTRUCTIONS - This form, properly filled out, should be placed in the file of the above numbered proceeding at the commencement of the hearing.

HEARING BEFORE (✓)

HEARD BY (NAMES)



TRADEMARK TRIAL AND APPEAL BOARD



BOARD OF PATENT INTERFERENCES



PRIMARY EXAMINER

J. E. Rice

R. L. Simms

G. D. Krugman

ADVERSARY PARTIES

COUNSEL

In re Kastle Systems, Inc.

Vs.

D. Kaul

*Trademark Examining
Attorney L. Beresford*

Vs.

Vs.

EXHIBIT 20

**THIS DISPOSITION
IS NOT CITABLE AS PRECEDENT
OF THE T.T.A.B.**

13 AUG 2002

Paper No. 13
RFC

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Zolo Technologies, Inc.

Serial Nos. 76/035,119; 76/035,120; 76/035,301

Thomas D. Bratschun of Swanson & Bratschun, L.L.C. for Zolo Technologies, Inc.

Kelly A. Choe, Trademark Examining Attorney, Law Office 113
(Odette Bonnet, Managing Attorney).

Before Simms, Cissel and Seeherman, Administrative
Trademark Judges.

Opinion by Cissel, Administrative Trademark Judge:

This is an appeal from the final refusals to register the marks in the above-identified three applications. Because the issues are closely related in each appeal, these cases have been consolidated. The marks, procedural histories and records are only slightly different. All three applications were filed on April 26, 2000. The basis for filing each application is applicant's assertion that it possesses a bona fide intention to use the mark in

Ser Nos. 76/035,119; 76/035,120; 76/035,301

commerce in connection with the goods set forth in the application.

The marks applicant seeks to register are "ZOLO," "ZOLO TECH," and "ZOLO TECHNOLOGIES." The descriptive word "TECHNOLOGIES" has been disclaimed in the application to register the latter mark.

The goods in each application, as amended, are as follows: "fiber optic communications components, namely, optical multiplexers, optical de-multiplexers, optical spectrum analyzers, reconfigurable add/drop multiplexers, electro optic solid state switches and external cavity semiconductor lasers, and multiplexed optical signal attenuators," in Class 9.

The Examining Attorney has refused registration of each of applicant's marks under Section 2(d) of the Lanham Act, 15 U.S.C. Section 1052(d), on the ground that applicant's marks so resemble the mark "SOLO," which is registered¹ for "optical fiber cable," that if applicant were to use these marks in connection with the fiber optic communications components specified in the applications, confusion would be likely.

¹ Reg. No. 2,150,858, issued on the Principal Register on April 14, 1998 to Siecor Corporation.

Applicant's marks either consist of the term "ZOLO" or combine it with the descriptive or suggestive terms "TECHNOLOGY" or "TECH." "ZOLO" is clearly the dominant portion of the two marks in which it is combined with these terms. The Examining Attorney reasons that confusion is likely because "ZOLO" is similar to "SOLO." He argues that because the letters "S" and "Z" can be pronounced the same way, "ZOLO" and "SOLO" are "essentially phonetic equivalents," (brief, p.7)², and the marks, when considered in their entireties, are similar because they create similar commercial impressions. Further, he takes the position that the goods with which applicant intends to use its marks are closely related to the goods set forth in the cited registration, so that if applicant were to use the marks it seeks to register in connection with the goods listed in the application, confusion with the cited registered mark would be likely.

Applicant disputes the Examining Attorney's assertions, arguing that the marks are not similar and that the goods are not so closely related that the use of the marks in question on them would be likely to cause confusion.

² In this opinion, references will be to the record in application S.N. 76/035,119 unless otherwise indicated.

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Both applicant and the Examining Attorney submitted briefs, but applicant did not request an oral hearing before the Board.

In support of the refusals to register, the Examining Attorney made of record the following: (1) An excerpt from Funk & Wagnalls New Encyclopedia (2000 edition) wherein it is noted that the letter "S" is "pronounced either voiceless, as the hissing sound in sun and nurse, or as a z, the voiced counterpart of s, in such words as prose and tease"; (2) A collection of excerpts from published articles in which words like "hospitalize" and "editorialize" are spelled with the letter "s" in place of the letter "z"; (3) Definitions of the words "multiplexer" and "attenuator" from Harcourt's Academic Press Dictionary of Science and Technology. The former is listed as "a device that allows the transmission of two or more signals on a single line or in a single frequency channel"; the latter as " a resistive or capacitative circuit designed to lower a signal amplitude to some desired value without distorting the signal waveform"; and (4) Copies of a number of third-party trademark registrations wherein the goods listed include switches, multiplexers,

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and/or attenuators, in addition to fiber optic cables.³

Applicant made of record three pages from the website of the owner of the cited registration and the declaration of Michael Wearsch, Vice President of Business Development/Marketing for applicant, who explains how the fiber optic market is divided, and that the website information indicates that "SOLO" fiber optic cable is sold to the "outside engineers" at "service providers," whereas applicant's fiber optic components are sold to "facility engineers" at "system providers."

In the case of E.I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973), the predecessor to our primary reviewing court set out the factors to be considered in determining whether confusion is likely. Chief among these factors are the similarity of the marks as to appearance, pronunciation, meaning and commercial impression, and the similarity of the goods set forth in the application and registration, respectively.

In the case at hand, the record establishes that the goods listed in the application are related to the product

³ Additional materials submitted with the appeal brief of the Examining Attorney have not been considered. Trademark Rule 2.142(d). In any event, they appear to relate to the relationship between the goods listed in the application and the goods specified in the registration, and the record establishes this relationship without the evidence untimely submitted with the brief.

identified in the cited registration. The people who make the decisions to purchase these products can be the same individuals within a given business organization, but these people are sophisticated and knowledgeable with regard to these products. Accordingly, they expend time and exercise care when purchasing these goods, and they would be likely to notice the differences between the marks.

Given this fact and the differences in the marks discussed below, we hold that confusion would not be likely.

Applicant and the Examining Attorney argue at length about the similarities and differences among the marks. The Examining Attorney argues that because one of the marks applicant seeks to register is "ZOLO" and "ZOLO" is the dominant portion of the other two marks applicant seeks to register, the issue boils down to whether "ZOLO" is similar to "SOLO." We cannot adopt his conclusion that these terms are "highly similar" because they both "contain the identical 'OLO' preceded by the phonetic equivalent letters, 'S' and 'Z.'" While it is true that in some instances these two letters can be pronounced in the same way and may be used interchangeably, these facts do not prove the Examining Attorney's contention that "[r]egistrant's mark, SOLO, may be pronounced as SOLO or

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ZOLO, and since applicant's mark, ZOLO, may be pronounced as ZOLO or SOLO; therefore, the marks are essentially phonetic equivalents." (brief, p. 7).

Rather, we agree with applicant that when these marks are considered in their entirety, applicant's marks are sufficiently different from the registered mark to avoid a likelihood of confusion. "ZOLO" and "SOLO" do share three letters, but the fact that one begins with the letter "Z" and the other begins with "S" results in significant differences in the way these marks look, the way they are likely to be pronounced, and their connotations, or lack thereof.

The Examining Attorney's argument that these terms are phonetic equivalents is not well taken. Clearly, the mark "SOLO," which is a common English word, would only be pronounced with an "S" sound. As for the mark "ZOLO," we are not persuaded that consumers would pronounce this invented term with an "S" rather than a "Z" sound. The examples provided by the Examining Attorney show only that "S" may be pronounced as "Z," not the reverse. The examples provided by the Examining Attorney which show the letter "S" actually used in place of the letter "Z" are all specifically designated as typical British spellings, rather than the preferred spelling in this country. Even

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in the cases where "S" is pronounced as "Z," the examples demonstrate this equivalency in pronunciation only when the letter "S" appears at the end of the word. No example provided by the Examining Attorney is analogous to the present case, i.e., we are provided with no examples where the letters "S" and "Z" are used interchangeably at the beginning of a word. As applicant points out, when these letters are substituted for each other at the beginnings of ordinary words, it is clear that they are not interchangeable. As examples, applicant suggests comparing "singer" to "zinger"; "zip" to "sip"; or "zag" to "sag."

Moreover, the dissimilarities between "ZOLO" and "SOLO" are not limited to differences in appearance and pronunciation. These two terms do not create similar commercial impressions because "SOLO" is a real word with a known meaning, whereas "ZOLO" is not. "SOLO" is understood as a reference to being alone, unaccompanied. In contrast, "ZOLO" is a fanciful term with no ascertainable meaning. We have previously found that the comparison of a known term with an unfamiliar one results in the conclusion that the marks are sufficiently distinguishable to avoid a likelihood of confusion. It is a well-settled principle that the familiar is readily distinguishable from the unfamiliar, and there is a line of decisions recognizing

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the distinction between the two. See: Laboratoires du Dr. N. G. Payot v. Southwestern Classics Collection, Ltd., 3 USPQ2d 1601, at 1606, (TTAB 1987), and cases cited therein.

In the case before us, we hold that if applicant were to use the marks it seeks to register in connection with the goods listed in these applications, confusion with the cited registered mark would not be likely because the marks, in their entireties, are not similar in appearance, pronunciation or connotation, and they create different commercial impressions.

DECISION: The refusals to register under Section 2(d) the Lanham Act are reversed.

EXHIBIT 21

THIS DISPOSITION IS
NOT CITABLE AS
PRECEDENT OF THE TTAB

Mailed: 12 JUN 2003
Paper No. 16
AD

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Beauty FX, Inc.

Serial No. 76/238,909

Marc J. Gross of Greenbaum, Rowe, Smith, Raven LLP for
Beauty FX, Inc.

Sophia S. Kim, Trademark Examining Attorney, Law Office 106
(Mary I. Sparrow, Managing Attorney).

Before Seeherman, Bucher and Drost, Administrative
Trademark Judges.

Opinion by Drost, Administrative Trademark Judge:

On April 12, 2001, Beauty FX, Inc. (applicant)
applied, under the intent to use provision of the Trademark
Act, to register on the Principal Register the mark COLOR
FX (in typed form) for goods ultimately identified as
"cosmetics, specifically, nail polish, nail care
preparations, eyeshadow, lip color, namely lip gloss and
lipstick, facial makeup, fragrances, namely perfumes and

colognes, mascara, and non-medicated skin-care preparations" in International Class 3.¹

The examining attorney has refused to register applicant's mark under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), because of the registration of the mark COLOR EFFECTS (in typed form) for "temporary hair color" in International Class 3.²

The examining attorney argues that the marks are similar because "(1) they share the word 'COLOR,' (2) they are both typed marks, and (3) they are phonetically equivalent." Brief at 4. Responding to applicant's criticism that the examining attorney only considered the phonetic equivalence in determining the similarity of the marks, the examining attorney stated "that this factor was the only significant factor to consider because other factors had no basis for argument." Id. As evidence of the phonetic equivalence, the examining attorney relies on an acronym dictionary and printouts from the U.S. Patent and Trademark Office search system that list "FX" as a pseudo mark for "effects." Regarding the goods, the examining attorney submitted several printouts that show

¹ Serial No. 76/238,909. The application contains a disclaimer of the word COLOR.

² Registration No. 2,232,963 issued March 16, 1999. The registration contains a disclaimer of the word COLOR.

that the same entity has registered cosmetics and hair care products under a common mark.

Applicant submits that the applicant's and registrant's marks have "completely different commercial impressions" (Brief at 6) and that FX can have many meanings. Applicant maintains that the "lack of a single common letter between the second word of COLOR FX and the second word of the Registered Mark is critical in distinguishing the commercial impression." Reply Br. at 4. In addition, applicant argues that while the goods of the parties may be described by the term "cosmetics," "they are cosmetics of different composition, used for different purposes in different channels." Brief at 9-10.

After the examining attorney made the refusal final, this appeal followed.

We reverse.

In a case involving a refusal under Section 2(d), we analyze the facts as they relate to the relevant factors set out in In re Majestic Distilling Co., 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). See also In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 1361, 177 USPQ 563, 567 (CCPA 1973). In considering the evidence of record on these factors, we must keep in mind that "[t]he fundamental inquiry mandated by § 2(d) goes to the

cumulative effect of differences in the essential characteristics of the goods and differences in the marks." Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

The first issue we address in this case is the similarity or dissimilarity of the marks. "When it is the entirety of the marks that is perceived by the public, it is the entirety of the marks that must be compared." Opryland USA Inc. v. Great American Music Show Inc., 970 F.2d 847, 23 USPQ 1471, 1473 (Fed. Cir. 1992). The crucial issue in this case is whether the similarity of the marks in sound alone is sufficient to support a holding that there is a likelihood of confusion. We view the examining attorney's statement that the similarity as to sound "was the only significant factor to consider because other factors had no basis for argument" (Brief at 4) as a concession that the marks are different as to appearance and meaning. We would certainly agree that, except for the apparently generic term "color," the marks have significant differences in appearance. Regarding the meanings of the marks, there are also differences. While the entry from the Acronym Finder lists one of the definitions of FX as "effects," it qualifies the meaning with the parenthetical "(special/sound)." To the extent that potential customers

would understand FX to mean "effects (special/sound)," it would have a movie special effects meaning. There is no evidence that registrant's mark would suggest any movie special effects connotation.³ The acronym finder also indicates that FX may be perceived as an acronym for several other words or as an abbreviation for other terms as well as simply the letters "F" and "X."

This brings us to a consideration of the similarity of the sound of the marks. We agree that the terms "FX" and "effects" are phonetically similar to the extent that when the letters F and X are pronounced, they would sound somewhat similar to the word "effects." However, the letters are not necessary phonetic equivalents. In the word "effects," the accent is on the second syllable; while, when the letters FX are pronounced, the letter "F" is given equal emphasis with the letter "X." Compare Traq, Inc. v. Trak, Inc., 212 USPQ 846, 850 (TTAB 1981) ("We conclude that the marks [TRAK and TRAQ] are phonetically indistinguishable. In this regard, we take judicial notice of the fact that the letter 'q' in the English language is always pronounced 'k'"); In re Total Quality Group Inc., 51

³ We also note that other definitions of FX such as "fix" may also come to mind when others see the term FX associated with "color" and used on cosmetics.

USPQ2d 1474, 1476 (TTAB 1999) ("Applicant's mark STRATEGYN and registrant's mark STRATEGEN are phonetic equivalents and differ by only one letter").

When marks are only similar in sound, we proceed a little more cautiously before determining that there is a likelihood of confusion. See e.g. Standard Brands Inc. v. Eastern Shore Canning Co., 172 F.2d 144, 80 USPQ 318, 321 (4th Cir. 1949), cert. denied, 337 U.S. 925 (1949) (V-8 and VA not confusingly similar, "the phonetic similarity of the two marks cannot prevail, even if it is supposed ... that the defendant's goods are asked for as VA rather than as Virginia tomato juice or lima beans"); Crown Radio Corp. v. Soundsciber Corp., 506 F.2d 1392, 184 USPQ 221, 222 (CCPA 1974) ("As we stated in General Electric Company Limited v. Jenaer Glaswerk Shott & Gen, 52 CCPA 954, 341 F.2d 152, 144 USPQ 427 (1965), confusing similarity cannot be predicated on auditory response alone and one must consider the impression on the mind where stimuli of the auditory nerve are registered").

In the present case, while FX can be pronounced similarly to the word "effects," it is not phonetically identical. The simple fact that the letters may be

pronounced similarly is a slender reed on which to base a likelihood of confusion determination.⁴

Inasmuch as there are admitted dissimilarities in appearance and meaning between the marks and the phonetic similarity is not unequivocal, we find that, when the marks are considered in their entirety, their differences outweigh their similarities.

Next, we compare the goods of applicant and the registrant. Here again, there are differences. Registrant's goods are limited to temporary hair color. Applicant's goods are nail polish, nail care preparations, eyeshadow, lip gloss, lipstick, facial makeup, perfume, cologne, mascara, and non-medicated skin-care preparations.⁵ The examining attorney has submitted seven use-based registrations to establish a relationship between applicant's and registrant's goods. Six of the

⁴ The examining attorney's only other "evidence" on this point consists of printouts from the Office's electronic database showing that in the database's pseudo mark field the Office has treated the letters "FX" as a pseudo mark for "effects." We have not considered this evidence. Because there is no procedure for applicants or third parties to challenge how the Office determines whether terms are "pseudo marks," the manner the Office enters a mark into its electronic search system is for the convenience of the Office. It cannot enhance or decrease the likelihood of confusion. Accord 15 U.S.C. § 1112 ("The Director may establish a classification of goods and services, for convenience of Patent and Trademark Office administration, but not to limit or extend the applicant's or registrant's rights").

⁵ Applicant deleted any goods directed to hair care.

registrations concern hair care products such as shampoo that are not the same as registrant's hair coloring products. There is one registration for highlighter (Registration No. 2,561,598), which can be a type of hair color product. However, we do not think this single registration is sufficient in the context of these particular goods to show that temporary hair color and the cosmetics identified in the application are the type of goods that may emanate from a single source. See In re Albert Trostel & Sons Co., 29 USPQ2d 1783, 1786 (TTAB 1993). We do not question that there is some relationship between applicant's and registrant's goods. However, we note that these goods are not identical and that the differences between the products are not inconsequential.

When we consider that the marks are different in appearance and meaning and the phonetic similarity is not identical, we find that the commercial impressions of the marks are different. When these marks are then used on different goods that are in the general field of health and beauty products, we hold that there is no likelihood of confusion.

Decision: The refusal to register is reversed.

EXHIBIT 22



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Opposition

Number: 91080932**Filing Date:** 08/07/1989**Status:** Terminated**Status Date:** 02/22/1998

Defendant

Name: NEW WORLD WINES ACQUISITION CORPORATION ASSIGNEE OF
SOMERSET VINTAGE CELLARS, INC.**Correspondence:** I. STEVEN SIGLIN
650 TOWN CENTER DRIVE, SUITE 550
COSTA MESA, CA 92626**Serial #:** 73701485 [Application File](#)**Registration #:** 2237870**Application Status:** Cancelled - Section 8**Mark:** CRYSTAL CREEK

Plaintiff

Name: CHAMPAGNE LOUIS ROEDERER, S.A.**Correspondence:** KUHN AND MULLER
405 LEXINGTON AVENUE
NEW YORK, NY 10174**Serial #:** 73183828 [Application File](#)**Registration #:** 1163998**Application Status:** Renewed**Mark:** CRISTAL CHAMPAGNE

Prosecution History

#	Date	History Text	Due Date
63	02/22/1998	TERMINATED	
62	07/16/1998	COURT'S DECISION: AFFIRMED	
61	09/24/1997	APPEAL TO CAFC	
60	06/25/1997	BOARD'S DECISION: DISMISSED	
59	09/25/1996	SUBMITTED ON BRIEF	
58	08/19/1996	PL'S BRIEF 3TC	
57	07/31/1996	P'S MOT FOR EXTEN. OF TIME W/ CONSENT	
56	06/19/1996	P'S MOT FOR EXTEN. OF TIME W/ CONSENT	
55	03/25/1996	P'S MOT FOR EXTEN. OF TIME W/ CONSENT	
54	01/22/1996	DEF'S OBJECTION TO REBUTTAL TESTIMONY	
53	01/22/1996	STIP TO SUBMIT TESTIMONY	
52	12/22/1995	P'S MOTION FOR AN EXTENSION OF TIME	
51	11/20/1995	P'S MOTION FOR AN EXTENSION OF TIME	
50	10/13/1995	P'S MOT FOR EXTEN. OF TIME W/ CONSENT	
49	09/05/1995	STIP TO SUBMIT TESTIMONIAL AFFIDAVITS	
48	08/28/1995	D'S MOTION FOR AN EXTENSION OF TIME	
47	08/23/1995	P'S MOT FOR EXTEN. OF TIME W/ CONSENT	
46	07/24/1995	P'S MOT FOR EXTEN. OF TIME W/ CONSENT	
45	06/15/1995	P'S MOT FOR EXTEN. OF TIME W/ CONSENT	

Prosecution History

#	Date	History Text	Due Date
44	05/18/1995	TRIAL DATES RESET	
43	10/12/1994	PL'S MEMO IN OPPOSITION TO DEF'S #43	
42	09/22/1994	DEF'S MOT TO COMPEL ANSWER TO WRITTEN QU ESTIONS & ENLARGEMNT OF #42	
41	08/12/1994	DEF'S NOTICE OF TAKING TESTIMONAL DEPOSI TION	
40	03/11/1994	TESTIMONY FOR PLAINTIFF	
39	05/27/1994	PROCS RESUMED; TRIAL DATES RESET	
38	05/11/1994	DEF'S RESPONSE TO #38	
37	04/18/1994	PARTIES ALLOWED 20 DAYS TO INFORM BOARD OF PROGRESS	
36	09/13/1993	PL'S RETURNED UNDELIVERABLE	
35	08/06/1993	P'S MOT FOR EXTEN. OF TIME W/ CONSENT	
34	06/04/1993	D'S MOT FOR EXTEN. OF TIME W/ CONSENT	
33	06/14/1993	DEF'S CROSS QUESTIONS MUST BE SERVED WITHIN 20 DAYS	
32	05/24/1993	PL'S CONSENT TO EXTENSION	
31	05/17/1993	D'S MOTION FOR AN EXTENSION OF TIME	
30	05/18/1993	DEF'S MOT TO STRIKE DENIED; PL'S MOT TO EXT GRT; PROCS O/W SUSP PEND DEPOSITIONS	
29	05/03/1993	DEF`S OPP TO #28	
28	04/26/1993	PL`S NOTICE OF TAKING TESTIMONY W/MOT TO EXT.TIME	
27	03/05/1993	TRIAL DATES RESET	
26	02/22/1993	PL`S #25 RETURNED UNDELIVERABLE	
25	02/09/1993	RECON DENIED; TRIAL DATES RESET	
24	01/07/1993	DEF'S REPLY BRIEF IN OPP TO #23	
23	12/11/1992	PL'S BRIEF RE: MOT TO RE-OPEN DISCOVERY	
22	11/23/1992	DF`S REPLY RE; #21	
21	10/30/1992	PL OPP TO REQ TO VACATE TRIAL ORDER	
20	10/13/1992	D'S OPPOSITION TO PL'S MOTION TO REOPEN	
19	09/28/1992	P'S MOTION FOR AN EXTENSION OF TIME	
18	09/17/1992	TRIAL DATES SET	
17	06/26/1992	P'S MOT TO SUSP PEND SETLMT NEGOT W CNST	
16	05/01/1992	DELICATE VINEYARDS JOINED AS PARTY DEF.	
15	04/14/1992	DEF MOT TO SUBSTITUTE PARTIES	
14	02/26/1992	P'S MOT FOR EXTEN. OF TIME W/ CONSENT	
13	11/04/1991	P'S MOT FOR EXTEN. OF TIME W/ CONSENT	
12	02/19/1991	STIPULATED MOTION FOR PROTECTIVE ORDER	
11	02/04/1991	P'S MOT FOR EXTEN. OF TIME W/ CONSENT	
10	09/14/1990	P'S MOT FOR EXTEN. OF TIME W/ CONSENT	
9	06/21/1990	TRIAL DATES RESET	
8	04/09/1990	D'S MOT FOR EXTEN. OF TIME W/ CONSENT	
7	02/20/1990	TRIAL DATES RESET	
6	01/22/1990	P'S MOT FOR EXTEN. OF TIME W/ CONSENT	
5	10/30/1989	TRIAL DATES SET	
4	10/16/1989	ANSWER	
3	09/15/1989	PENDING, INSTITUTED	
2	09/15/1989	NOTICE SENT; ANSWER DUE (DUE DATE)	10/25/1989
1	08/07/1989	FILED AND FEE	

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POLICY

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Final Decisions of the Trademark Trial and Appeal Board

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06/25/1997	OPP	91080932	Champagne Louis Roederer, S.A. v. Delicato Vineyards	Sams Rice* Seeherman	2(d)	Opposition Dismissed	"CRISTAL" and "CRISTAL CHAMPAGNE" [champagne]	"CRYSTAL CREEK" [wines]			NO

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1997 TTAB LEXIS 61, *

Champagne Louis Roederer, S.A. v. Delicato Vineyards

Opposition No. 80,932 to application Serial No. 73/701,485 filed on December 17, 1987

Trademark Trial and Appeal Board

1997 TTAB LEXIS 61

June 25, 1997, Decided

CORE TERMS: opposer, registration, champagne, cristal, crystal, wine, pleaded, purchaser, pronunciation, declaration, objected, judicial notice, creek, third-party, transparent, dictionary definition, likely to cause, rebuttal testimony, dictionary, trademark, liquor, interrogatory, deposition, appearance, restaurant, sparkling, commerce, channels, notice, retail

DISPOSITION:

[*1]

Decision: The opposition is dismissed.

COUNSEL:

Perla M. Kuhn and Julius Rabinowitz of Kuhn and Muller for opposer.

I. Steven Siglin, Esq. for applicant.

JUDGES: Before Sams, Rice, and Seeherman, Administrative Trademark Judges.**OPINION BY:** RICE**OPINION:**

Opinion by Rice, Administrative Trademark Judge:

An application has been filed by Somerset Vintage Cellars, Inc., and subsequently assigned to New World Wines Acquisition Corporation and then to Delicato Vineyards, n1 to register the mark CRYSTAL CREEK for wines. n2

n1 The assignment from New World Wines Acquisition Corporation to Delicato Vineyards occurred after the commencement of this proceeding, but prior to the opening of the testimony periods. In accordance with the Board's customary practice in such instances (see

§ 512.01 of the *Trademark Trial and Appeal Board Manual of Procedure* ("TBMP")), Delicato Vineyards was joined, rather than substituted, as a party defendant. Inasmuch as the discovery and testimony periods have now closed, Delicato Vineyards is hereby substituted as party defendant.

n2 Application Serial No. 73/701,485, filed December 17, 1987, asserting first use and first use in commerce on April 16, 1987. **[*2]**

Registration has been opposed by Champagne Louis Roederer, S.A., a French joint stock company, under Section 2(d) of the Trademark Act of 1946, 15 U.S.C. § 1052(d), on the ground that applicant's mark, as applied to its goods, so resembles the marks CRISTAL and CRISTAL CHAMPAGNE, previously used by opposer in the United States for champagne, as to be likely to cause confusion, or to cause mistake, or to deceive. Opposer also pleaded ownership of a registration of its mark CRISTAL CHAMPAGNE, n3 and that the mark has become famous in the United States.

n3 Registration No. 1,163,998 issued August 4, 1981, under the provisions of Section 2(f) of the Act, 15 U.S.C. § 1052(f), with a disclaimer of CHAMPAGNE, from an application filed August 28, 1978 claiming first use anywhere on May 13, 1876 and first use in commerce on March 25, 1937; affidavit Sec. 8 accepted; affidavit Sec. 15 received.

Applicant, in its answer to the notice of opposition, has denied the salient allegations thereof.
n4

n4 Applicant also pleaded 10 "affirmative defenses," all of which are lacking in that they are not true affirmative defenses, or are legally insufficient, and/or constitute a collateral attack upon opposer's pleaded registration and, as such, cannot be entertained in the absence of a counterclaim to cancel the registration. "Shotgun pleading" of this nature is strongly disfavored by the Board, and counsel for applicant would be wise to avoid such pleading in future cases before the Board. **[*3]**

The record consists of the pleadings; the file of applicant's subject application; copies of two registrations owned by opposer; n5 the testimony upon written questions of opposer's vice president, Fabrice Rosset; the testimony declarations of Patricia Towers and Beth Brown in behalf of applicant; and the rebuttal testimony declaration of opposer's witness Fabrice Rosset. n6 Both parties briefed the case; neither requested an oral hearing.

n5 The registrations were made of record as an exhibit to the testimony of opposer's witness, who testified as to their current status and title. One of the registrations so made of record by opposer was the registration pleaded in the notice of opposition. The second registration was Registration No. 662,343 for the mark CRISTAL CHAMPAGNE and design (CRISTAL CHAMPAGNE disclaimed), issued May 27, 1958 from an application filed October 29, 1956, claiming first use anywhere on May 13, 1876 and first use in commerce on March 25, 1937; affidavit Sec. 8 accepted; once renewed. Although this registration was not pleaded by opposer, applicant did not object to it as unpleaded, and thus this objection is deemed waived.

Applicant did assert in its brief that because opposer made the certificate of its pleaded registration of record, the entire file of the registration should be considered to be of record in this case. However, it is only the registration certificate, with the presumptions flowing therefrom, that is of record herein. If applicant wanted us to consider the entire file of the registration, it was incumbent upon applicant to make a copy of the file contents properly of

record during its testimony period, such as by filing, during that period, a copy of the file contents together with a notice of reliance thereon. See TBMP § 703.02(a) (last paragraph). Although applicant attached parts of the registration file to its brief on the case, exhibits and other evidentiary materials attached to a party's brief on the case can be given no consideration unless they were properly made of record during the time for taking testimony. See TBMP § 705.02, and cases cited therein. **[*4]**

n6 The parties stipulated to the introduction of the testimony of Patricia Towers and Beth Brown, and the rebuttal testimony of Fabrice Rosset, in declaration form.

Opposer's evidence indicates that the mark CRISTAL was first adopted and used by opposer (outside of the United States) in 1876, when opposer developed a special champagne for the Russian czar and bottled it in genuine crystal. Opposer has used the marks CRISTAL and CRISTAL CHAMPAGNE in the United States in connection with champagne continuously since 1937, except for a period of disrupted use during World War II. n7 Opposer's champagne bearing these marks is sold throughout the United States in prestige retail outlets, hotel restaurants, and supermarkets. It is carried in this country by more than 80 distributors and about 4,000 retailers, restaurants, etc. Opposer's annual advertising expenditures for the product in the United States amounted to more than \$ 100,000 for each of the five years preceding February 28, 1994 (the date of Mr. Rosset's testimony deposition). In addition, the product has frequently been featured in articles appearing in such publications as Wine Enthusiast, Wine & Spirits, Gourmet, Wine **[*5]** News, Bon Appetit, The Wine Spectator, The Press-Enterprise, Miami Herald, Sun-Tattler (Hollywood, Florida), and Chicago Sun-Times.

n7 There is testimony that the mark CRISTAL was licensed for use on cavier in 1983. However, there is no evidence as to the extent of the use, if any, made under this license.

Sales of opposer's champagne bearing the marks CRISTAL and CRISTAL CHAMPAGNE in the United States amounted to approximately 150,000 bottles, having a wholesale value of more than \$ 40 million, and a retail value of more than \$ 80 million, for each of the five years preceding Mr. Rosset's testimony. The champagne sells in the United States for between \$ 90 and \$ 120 per bottle; it is one of the most expensive champagnes sold in this country.

Opposer's witness Mr. Rosset is not aware of any instances of actual confusion arising from the use of opposer's mark CRISTAL for champagne and applicant's mark CRYSTAL CREEK for wine. Opposer first became aware of applicant's use of the mark CRYSTAL CREEK on May 25, 1989, and has never objected to that use. n8

n8 This opposition, however, was filed on August 7, 1989.

In response to a question by applicant as to whether **[*6]** opposer has ever raised any objection to the use or registration of certain specified marks (identified in the question only by mark and a registration number or application serial number, without any information as to the goods) n9 in the United States, Mr. Rosset stated that opposer had objected to three of the marks, CRYSTAL OAK CELLARS, CALIFORNIA CRYSTAL, and CRYSTAL COMFORT, and that in all three cases, opposer has been successful "in persuading the owner of the registration or the user of the marks to stop using the mark or persuaded it or him to give up to [sic] the registration."

n9 As noted by opposer in its reply brief, applicant's mere reference in its question to these marks and their asserted registration numbers or application serial numbers does not suffice

to make the registrations or applications of record. For information concerning the proper method for making third-party registrations or applications of record, see TBMP §§ 703.02(b) and 703.03.

Applicant's witnesses, Patricia Towers and Beth Brown, testified concerning third-party uses of marks containing the term CRYSTAL or variations thereof for beverages. n10 Specifically, Patricia Towers testified **[*7]** that on August 21, 1995 she visited Central Liquors, a retail liquor store in Washington, D.C., and found there AGUARDIENTE CRISTAL, a (liquor) product of Columbia; CRYSTAL Lager Beer and CRYSTAL Diplomat Dark Beer, both distributed by a company of the Czech Republic; and CRYSTAL PALACE GIN, manufactured by Barton Distilling.

n10 Opposer objected to some of applicant's third-party use evidence on the ground that the uses in question were not identified in applicant's responses to opposer's interrogatories, including interrogatory 17. However, opposer failed to file a copy of its interrogatories in support of the objection, so we cannot determine whether the objection is well-taken. Moreover, opposer failed to preserve the objection in its brief on the case. Under the circumstances, the objection cannot be sustained.

Beth Brown's testimony establishes that in early June 1995, she visited certain establishments and found there certain third-party beverage products, namely, at Hi-Time Cellars, a retail liquor, tobacco, etc., store located in Costa Mesa, California, she found CRYSTAL GEYSER sparkling mineral water, AGUARDIENTE CRISTAL liquor, and STOLICHNAYA CRISTALL vodka; at each **[*8]** of four different Von's supermarket stores (1 in Costa Mesa, California, 1 in Anaheim, California, and 2 in Santa Ana, California), she found CRYSTAL GEYSER sparkling mineral water, CRYSTAL LIGHT soft drinks, and STOLICHNAYA CRISTALL vodka; at Trader Joe's grocery store in Costa Mesa, California, she found CRYSTAL GEYSER alpine spring water; at Cost Plus Imports store in Santa Ana, California, she found CRISTALINO sparkling water; at Tony's Sea Landing Restaurant in Tustin, California, she found CRYSTAL LAKE wines; at Felix Continental Cafe restaurant in Orange, California she found CRYSTAL LAKE wines, sparkling wine, and California champagne; at Back Bay Cafe in Newport Beach, California, she found CRYSTAL LAKE California champagne; and at The Wine Exchange in Orange, California, she found STOLICHNAYA CRISTAL vodka.

In his rebuttal testimony declaration, dated December 12, 1995, Mr. Rosset stated that in August 1995, opposer learned that applicant claimed a company was selling wine products in the Orange County, California area under the mark CRYSTAL LAKE; that opposer had never heard of this use before; that subsequently, opposer learned that the company in question was San Antonio **[*9]** Winery, Inc.; that on October 23, 1995, opposer sent that company a cease and desist letter; and that the company responded by asking if it could resolve the matter through negotiation of a license agreement. n11

n11 Applicant has objected to this declaration on the ground of hearsay. However, we are not persuaded that the objection is well-taken.

Aside from the fact that opposer owns a registration of its mark CRISTAL CHAMPAGNE for champagne, so that the issue of priority does not arise as to the mark, n12 the record clearly establishes opposer's long-prior use of its marks CRISTAL and CRISTAL CHAMPAGNE. Thus, the only issue to be determined herein is the issue of likelihood of confusion.

n12 See *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).

Turning first to the goods of the parties, wine and champagne are very closely related. Indeed, as indicated by the cross-examination testimony of Mr. Rosset (pages 21-22 of the deposition), champagne is a type of wine. n13 Applicant's brief is replete with arguments based on asserted differences between the respective goods of the parties as to price, channels of trade, [*10] classes of purchaser, etc. However, applicant offered no evidence as to the price range, channels of trade, classes of purchaser, etc. for its goods. Moreover, the issue of likelihood of confusion must be determined on the basis of the identification of goods in applicant's application and the goods specified in opposer's registration (as well as the goods on which opposer has proved prior use of its mark). Inasmuch as the parties' identifications of goods contain no restrictions as to these matters, they must be considered to include wines (in applicant's case) and champagne (in opposer's case) sold in all of the usual price ranges, through all of the customary trade channels, to all of the normal classes of purchasers, for goods of the type identified. That is, for purposes herein, we can draw no distinctions between the goods of the parties as to price, channels of trade, or classes of purchasers. Under the circumstances, we have no doubt that the contemporaneous marketing by applicant and opposer of wine and champagne, respectively, under the same or similar marks would be likely to cause confusion.

n13 Specifically, Mr. Rosset testified that technically speaking, "champagne" means sparkling wine produced in the Champagne appellation zone of France in accordance with strict regulations concerning all aspects of production, planting, the choice of grape varieties, harvesting, wine making, etc., but that people in the United States generally use "champagne" for any category of sparkling, effervescent wines. Similarly, in Webster's New World College Dictionary (3rd ed. 1997), "champagne" is defined as, inter alia, "1 orig., any of various wines produced in Champagne, France 2 a) now, any effervescent white wine made there or elsewhere. . . ." [*11]

This brings us to the marks. We note at the outset that applicant's assertion, on page 9 of its appeal brief, that opposer's mark "is purely descriptive, and has come to serve as a generic reference to a pure, high quality product", and other similar assertions in the brief and in applicant's pleading, constitute collateral attacks upon the validity of opposer's pleaded registration and as such cannot be entertained in the absence of a counterclaim or separate petition to cancel the same. See *Contour Chair-Lounge Co., Inc. v. Englander Co., Inc.*, 324 F.2d 186, 139 USPQ 285 (CCPA 1963), and *Clorox Co. v. State Chemical Manufacturing Co.*, 197 USPQ 840 (TTAB 1977). Moreover, it is clear that, as a result of opposer's long and extensive use of its mark over the years, with resulting recognition, any weakness which the mark may have had initially has long since been overcome, and the mark has come to serve as a very strong indication of origin for opposer's champagne.

Similarly unpersuasive are applicant's arguments based on differences in the labels used by the parties. Aside from the fact that the specimens in an application do not constitute evidence [*12] in applicant's behalf unless they are identified and introduced in evidence as exhibits during the period for taking testimony [Trademark Rule 2.122(b) (2), 37 CFR § 2.122(b)(2)], which applicant here did not do, it is well settled that the issue of likelihood of confusion in a proceeding such as this must be determined on the basis of the mark sought to be registered, as shown in the application drawing, vis-a-vis the mark shown in opposer's registration, n14 without consideration for other matter which may be used therewith. See, for example, *Kimberly-Clark Corp. v. H. Douglas Enterprises, Ltd.*, 774 F.2d 1144, 227 USPQ 541 (Fed. Cir. 1985); *Miles Laboratories Inc. v. Naturally Vitamin Supplements Inc.*, 1 USPQ2d 1445 (TTAB 1986); *Purex Corp., Ltd. v. Thompson-Hayward Chemical Co.*, 179 USPQ 190 (TTAB 1973).

n14 Opposer is also entitled to rely, of course, on any other mark as to which it has shown prior use.

Further, the lack of evidence of actual confusion is of little significance in a case such as this, where there is no evidence as to the nature and extent of applicant's use. That is, we cannot **[*13]** determine whether there has been any real opportunity for confusion to arise. In any event, the standard under Section 2(d) is likelihood of confusion, not actual confusion.

Finally, applicant's argument that CRISTAL and CRYSTAL have different pronunciations is not well taken. As noted by opposer, there is no correct pronunciation of a trademark [*Kabushiki Kaisha Hattori Seiko v. Satellite International Ltd.*, 29 USPQ2d 1317 (TTAB 1991); *Jockey International Inc. v. Mallory & Church Corp.*, 25 USPQ2d 1233 (TTAB 1992); and *Yamaha International Corp. v. Stevenson*, 196 USPQ 701 (TTAB 1977)], and we have no doubt that a substantial segment of the purchasing public for goods of the type involved here would pronounce CRISTAL and CRYSTAL in a similar manner.

Notwithstanding all of the foregoing, we find that there is no likelihood of confusion in this case because of the differences in the marks CRISTAL and CRISTAL CHAMPAGNE, on the one hand, and CRYSTAL CREEK, on the other. Comparing applicant's mark CRYSTAL CREEK, considered in its entirety, to opposer's mark CRISTAL (the mark of opposer which is most similar to applicant's mark), it **[*14]** is clear that the two marks differ substantially in significance. We note, in this regard, that the noun "crystal" is defined in Webster's New World College Dictionary, supra, as, inter alia, "a clear, transparent quartz"; "a very clear, brilliant glass"; "articles made of this glass, such as goblets, bowls, or other ware"; and "anything clear and transparent like crystal", while the adjective form of the word is defined as, inter alia, "of or composed of crystal" and "like crystal; clear and transparent." Opposer's mark CRISTAL is likely to be recognized by purchasers as the French language equivalent of the English word "crystal" n15 or, to those unfamiliar with the French language, as a phonetic misspelling of the word "crystal." In either case, CRISTAL would likely signify to purchasers (in addition to its acquired significance as a trademark for opposer's champagne) the clear or transparent nature of opposer's champagne, n16 and/or the crystal bottles in which the product was originally sold. Applicant's mark CRYSTAL CREEK, in contrast, conjures up the image of a very clear (and hence probably remote from civilization) creek or stream. n17 Moreover, there are differences between **[*15]** the marks in sound and appearance. Because of the differences in the marks in significance, sound, and appearance, they create distinctly different commercial impressions.

n15 Attached to applicant's brief on the case was a page from Cassell's French Dictionary showing that the French word "cristal" is defined as "Crystal, fine glass, crystal ware, cut glass; (fig.) limpidity." The dictionary definition evidence was offered by applicant in support of its arguments concerning the pronunciation of the marks. Opposer has objected to our consideration of this evidence, on the grounds that it was not properly submitted during applicant's testimony period, and that it is improper for the Board to take judicial notice of the dictionary definition of a foreign word. For the reasons indicated earlier in this opinion, applicant's arguments concerning the proper pronunciations of the marks are not well taken, and we have not considered the dictionary entry for pronunciation purposes. On the other hand, it is well settled that the Board may take judicial notice of the definitions of words in dictionaries. See *B.V.D. Licensing Corp. v. Body Action Design Inc.*, 846 F.2d 727, 6 USPQ2d 1719 (Fed. Cir. 1988); *In re Sarkli, Ltd.*, 721 F.2d 353, 220 USPQ 111 (Fed. Cir. 1983); and *In re Anania Associates, Inc.*, 223 USPQ 740 (TTAB 1984). Opposer's objection that we cannot take judicial notice of the meanings of words in foreign dictionaries is not convincing. Here, we take judicial notice of the French dictionary definition of "cristal" to show its significance to those in the United States who are familiar with the French language. **[*16]**

n16 Opposer's witness Mr. Rosset testified, at pages 24-25 of his testimony deposition, that opposer has never sold, under the mark CRISTAL, any champagne that was opaque in appearance.


n17 The noun "creek" is defined in Webster's New World College Dictionary, *supra*, as "a small stream, somewhat larger than a brook."


Opposer argues that CRYSTAL is the dominant part of applicant's mark because it is the first word thereof, and that where the dominant portions of two marks are the same or highly similar, likelihood of confusion is more readily found. Inasmuch as CRYSTAL is an adjective modifying the word CREEK, however, we cannot agree with this analysis. Nor does the fact that CREEK is a topographical designation mean that it is in any way lacking in trademark significance as applied to wines.

For the reasons set forth above, we conclude that applicant's mark CRYSTAL CREEK, when applied to wines, does not so resemble opposer's marks CRISTAL and CRISTAL CHAMPAGNE as to be likely to cause confusion.

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
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